Petition

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IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1981

No. 81-

TRANS TECH, INC.,

Petitioner-Defendant,

- and -

FIRMA WOLF and AREND WOLF,

Defendants,

- against -

INTERDYNAMICS, INC. and SMITHS INDUSTRIES, LIMITED,

Respondents-Plaintiffs.

ON REVIEW FROM THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

PETITION FOR CERTIORARI

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Questions Presented for Review

1. Must the claims of the patent be the measure of the scope of any consent judgment conceding patent validity and patent infringement; and specifically, can the test of "colorable difference" be rationally applied by comparing the accused product with the admittedly infringing product without reference to the patent claim?

2. Can the doctrine of equivalents be applied without reference to the underlying patent?

3. Can the doctrine of equivalents be applied without taking into consideration the extent to which the doctrine of file wrapper estoppel limits application of the doctrine of equivalents?

4. Can an injunction against patent infringement provide protection both broader than the scope of the patent and broader than the combination of elements constituting the admittedly infringing product?

5. Is it due process of law to hold a party in contempt of an injunction against infringement of a patent by reason of the marketing of a product which omits an element of the concededly infringing product, which element is also a limitation of the patent claims?

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ON REVIEW FROM THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

Opinions Below

The opinion of the District Court for the District of New Jersey is not reported and appears at Appendix A (a-1). The opinion of the Court of Appeals for the Third Circuit is reported at 653 F. 2d 93 (1981). It appears at Appendix B (a-12).

Jurisdiction

(i) Review of the judgment of the Court of Appeals for the Third Circuit, made and entered on June 30, 1981, is hereby sought. A true copy of said judgment is appended at Appendix C (a-25). Said judgment reversed the order of the District Court, made July 3, 1980 and entered on July 7, 1980. A true copy of the District Court judgment is appended at Appendix D (a-26).

(ii) A petition for rehearing of said judgment of June 30, 1981 was denied by an order of the Circuit Court of Appeals of the Third Circuit dated July 23, 1981, a true copy of which is annexed hereto as Appendix E (a-28).

(iii) Jurisdiction is conferred on this court by 28 U.S.C. 1254 (1).

Statutes Involved

Section 401 of Title 18 and Section 2106 of Title 28 of the United States Code and Rules 52(a) and 65(d) of the Federal Rules of Civil Procedure are involved in this matter. The text of Sections 401 and 2106 and Rules 52(a) and 65(d) appears at Appendix F (a-29).

Statement of Facts of the Case

Petitioner, Trans Tech, Inc. ("Trans Tech") and respondent, Interdynamics, Inc. ("Interdynamics") both distribute automobile accessories for the so-called "after-market" as opposed to original equipment installed in new automobiles by automobile manufacturers. Interdynamics is a licensee of respondent Smiths Industries, Ltd. ("Smiths"), which is the owner by assignment of a patent granted to one Barnard by the United States Patent Office on September 14, 1973 under Patent No. 3,757,087 ("Barnard Patent"). The patent covers a kit for a rear window automobile defroster. A copy of the patent appears at Appendix G (a-63).

Prior to the Barnard Patent, there were a number of other rear window defroster devices marketed. Until 1960 the principal device was basically a warm air fan which was directed against the inside surface of the rear window. In 1960, automobile manufacturers embedded thin electrical wires within the glass of the rear window. In subsequent years, they applied stripes of electrically conductive paint to the inner surface of the rear window. In both cases, the embedded wires or the conductive stripes were energized by wire connections to the car battery or generator. A common after-market device con-

sisted of thin electrical wires in a fixed array sandwiched between plastic laminates. The device was attached to the rear window by suction cups or adhesives and was also energized by wires running to the electrical supply of the automobile.

The Barnard device is also a fixed array of electrical wires in a sandwich but employing two discardable plastic sheets instead of permanent plastic laminate on both sides of the wires. The discardable sheets permit direct mounting of the electrical wires onto the window. The array is maintained on the window by an adhesive initially activated by hand pressure and increasing in efficiency when electrically energized in the course of using the device.

The Barnard Patent claimed to overcome the disadvantages of the plastic laminate device, viz: discoloration and the accumulation of dust and grime.

The Patent Office, in granting the Barnard Patent, rejected a claim of the respondents for a patent on a rear window defroster which did not contain *two* separate detachable sheets. In rejecting the claim, the Patent Office relied upon the prior art which showed many devices on a single detachable sheet. *See* Footnote 2 of the Opinion of the District Court, Appendix A (a-9). Under the doctrine of "file wrapper estoppel" (*Graham v. Deere*, 383 U.S. 1, 33), the respondents, by acquiescing in the Patent's rejection of a claim with a single sheet, agreed that its patent only covered rear window defroster kits whose heating elements were mounted between two detachable sheets.

In 1978 Trans Tech began to market a defroster kit (the "Wolf product"). The Wolf product consisted of four strips, approximately three inches in width and fifty inches in length. Each strip was comprised of two detachable covers sandwiching two thin electrical wires between them. Application to the window was achieved by removing one of the covers from one of the strips and pressing the remaining cover with the two wires facing the window on the window horizontally. The remaining cover was then removed, leaving the two wires on the window. The process was repeated with the remaining strips to form a horizontal grid which was closed by the addition of vertical elements connecting the horizontal elements.

After Trans Tech commenced marketing the Wolf product, Interdynamics and Smith brought an action in the United States District Court of New Jersey in March 1978 against Trans Tech and Firma Wolf claiming infringement of the Barnard Patent.

On September 6, 1978, Trans Tech entered into a consent judgment whereby Trans Tech agreed that the Barnard Patent was valid; that the Wolf device infringed the Barnard Patent; and that Trans Tech would be permanently enjoined from infringing the patent. *See* Appendix H (a-31).

As a condition to Trans Tech entering into the consent judgment, Trans Tech received a letter from counsel for Interdynamics and Smiths that acknowledged, on behalf of Interdynamics and Smiths, that Trans Tech could continue to manufacture rear window defrosters so long as such defrosters did not infringe the Barnard Patent. *See* Appendix I (a-33).

At the time that Trans Tech agreed to enter into the consent decree, it had consulted its patent counsel regarding the propriety of marketing a new device in light of the Barnard Patent and the consent decree. Patent counsel advised Trans Tech that the new device was non-infringing and would not violate the decree. Relying on counsel's opinion, in October of 1978 Trans Tech commenced manufacturing and marketing the new product.

Unlike the Barnard Patent and Wolf device, the new device consisted of a single strip approximately three inches wide and 20 to 42 feet in length to which were affixed two parallel thin wires. The single strip is pressed horizontally across the car window, and the electrical wire elements, having an adhesive coating, adhere to the car window. The supporting strip is then pulled free leaving the wires on the car window. The adhesive holding the wires to the window is more binding than the adhesive between the removable strip and the wires. For ease of handling, shipping and installing, the strip is rolled into a coil, like adhesive tape or masking tape. As the strip is applied to the car window, it is cut to size. Four to nine horizontal parallel double rows of heating elements are applied from the coil in the manner described immediately above. Vertical electrical elements are connected to the ends of the horizontal

wires to complete the grid and supply energy from the car battery.

Interdynamics brought on a contempt proceeding against Trans Tech alleging that the marketing of the new device violated the consent judgment. After a day of hearing on the issue of contempt, wherein the new product was compared to the adjudicated Wolf product and to the Barnard Patent, Judge Biunno, in an oral decision of November 13, 1978, held that Trans Tech was not in contempt of the permanent injunction. Judge Biunno found that the new product differed from the Wolf product because the new product eliminated one of the discardable strips. Appendix J (a-46). Although he found that he could not summarily find Trans Tech in contempt, Judge Biunno decided that a full hearing should be had on whether or not the new product violated the terms of the permanent injunction and the claims of the Barnard Patent. After a full hearing held in April 1979, Judge Biunno determined on January 21, 1980 that the new product did not infringe upon the Barnard Patent and did not violate the injunction.

Interdynamics and Smiths took an appeal to the Third Circuit in August 1980. On June 30, 1981, Third Circuit reversed the District Court, holding that the lower court applied the wrong legal test with respect to contempt. It was the opinion of the Circuit Court that the District Court should only have compared the new product to the adjudicated product, without reference to the claims of the patent, to determine whether the products were merely colorably different. The Circuit Court then made its own comparison and found the products to be merely colorably different. It reversed the lower court and held Trans Tech in contempt.

Like the District Court, the Third Circuit premised its decision on the "significance of the presence or absence of a separate backing sheet." Appendix B (a-23). The Third Circuit found that the absence of the separate backing sheet made little difference because the new product was placed in a coil and by reason thereof was able to use the reverse side of the single sheet as a protective cover in the same manner as if there were two separate sheets. This finding ignored the Patent Office's

refusal to grant a patent for a defogger kit with heating wires mounted on a single disposable sheet.

In making this disposition, the court said that it was not necessary to decide whether Trans Tech's new product infringed the Barnard Patent. Appendix B (a-24).

Arguments for Allowance of this Petition

1. An Important Federal Question Has Been Raised And Should Be Settled.

The Third Circuit has decided an important question of Federal law, namely, can the issue of contempt be summarily determined by comparing the accused product to the adjudicated product without reference to the claims of the patent. The Third Circuit says it can.[1] While this question is one of first impression for the Third Circuit, for reasons set forth in points 2 and 3 below, the holding of the Third Circuit runs contrary to the decisions of this court and conflicts with the decisions of the other circuits. If the Third Circuit's decision is permitted to stand, it will have the following adverse consequences:

(a) Settlements of patent suits will be discouraged because patent counsel will have no real frame of reference, *i.e.*, the claims of the patent, in determining whether a new product is more than colorably different from the adjudicated product;

(b) Patent counsel will be constantly seeking declaratory judgments from the courts with respect to the new products where consent decrees have been entered;

(c) The Third Circuit's decision will reward economically powerful corporations having narrow patents by permitting these corporations to thwart competition through

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[1] The Third Circuit arrives at this result in the interest of assuring finality of litigation. Finality of litigation is not the issue, but rather the issues are: what is the scope of the prohibition contained in the consent decree, and how does the court determine the same. As will be demonstrated below, the answers to these two issues are not obtained by the facile comparison of the accused product to the infringing product.

undeserved extensions of the scope of these narrow patents; such extensions are contrary to the public policy of the patent law, *Mercoid v. Mid-Continent Investment*, 320 U.S. 660, at 666, 670 (1943)[2] and *Lear v. Adkins*, 394 U.S. 653 (1969); and

(d) The decision will restrain legitimate non-infringing competition by the people who are in the best position to compete with the patent holder. *Lear v. Adkins*, 395 U.S. 670.

2. The Decision Of The Third Circuit Conflicts With The Decisions In Other Circuits.

The decision of the Third Circuit states that it has hitherto never considered the question of how to deal with a consent decree in an infringement action after the infringer "sell[s] a modified version of the infringing product." Appendix B (a-18). The decision then enunciates a rule of law for which it cites decisions in other circuits, particularly *McCullough Tool Company v. Wells Surveys, Inc.*, 395 F. 2d 230 (1968), decided in the Seventh Circuit; *Siebring v. Hansen*, 346 F. 2d 474 (1965), decided in the Eighth Circuit, and *Hopp Press Inc. v. Freeman & Co.*, 323 F. 2d 636 (1963), decided in the Second Circuit. The rule of the Third Circuit is stated as follows:

> ". . . the appropriate inquiry is whether the new product alleged to be a contempt is 'merely colorably different' from the product previously conceded to infringe." Appendix B (a-21).

The rule of law is not only so vague as to fail to provide a standard, but is also entirely inconsistent with the rule enunciated in the three other circuits, the decisions of which are cited. The stated rule, neither explicitly nor implicitly, sets forth, or even remotely suggests, the standards to be applied in determining the question of colorable difference. Other language of the Third Circuit's decision explicitly provides that a *prohibited*

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[2] In *Mercoid*, this court said:

". . . it (the patent) results from inventions and *is limited to the invention which it defines.*" (Emphasis supplied) 320 U.S. 666.

standard is one which in any way makes reference to the underlying patent or its context. Thus, immediately preceding the statement of the above quoted rule, the court states that it "must focus on the products rather than the patent itself." Appendix B (a-21). Also, at footnote 1 of the decision, Appendix B (a-16), the Circuit Court takes the Districts to task because the District Court, in applying the concept of colorable difference, stated that the difference between the admittedly infringing product and the accused product must be examined "in relation to the patent." In short, the Third Circuit not only rejected the claims of the patent as a valid test but also rejected any reference to the patent or its context in determining the question of colorable difference.

Such a rule is in direct conflict with the rulings in the cases cited by the Third. In *McCullough*, *supra*, and *Siebring*, *supra*, the rule enunciated (citing numerous prior cases in the same and other circuits) is that the initial inquiry to be made by the court is whether the accused device is merely colorably different from the enjoined device *or from the patent*. *McCullough* at p. 477.

The egregious error made by the Third Circuit was to *prohibit* any reference to the patent claims or context, much less omit the context of the patent in the rule it propounded. The concept that the patent is irrelevant to the question of colorable difference is not only alien to the decisions in the other circuits, it is alien to due process of law. Without reference to the patent claims, there are no guidelines for litigants or their attorneys. Indeed, there are no guidelines for the courts to determine what is mere colorable difference.

The most that a patentee can expect to realize from a consent decree entered into by an infringer is (a) the admission that his patent is valid, (b) that its scope is as broad as the claim filed with the Patent Office, and (c) with respect to the infringer only, that the scope of the patent has been extended to cover the admittedly infringing device. That is to say, that even if such device did not infringe the patent, with respect to the infringer, it is deemed to have infringed the patent.

However, if the infringer markets a new product which omits an element or relationship found in the admitted infringing

device and where that same element or relationship is set forth as one of the limitations of the claims of the patent, then it is submitted that the court *must* find the new product to be more than colorably different from the infringing device. Otherwise, the infringer can be held in contempt for marketing of a product which in fact does not infringe and in fact omits a crucial claimed element of the device earlier admitted to be infringing. To find contempt in such circumstances goes beyond the scope of the consent decree and injunction; is necessarily in conflict with the other circuits; and imposes the serious sanction of contempt without due process of law.

While *McCullough* and *Siebring, supra*, compared the accused product with the enjoined product *or* the patent, it is clear that these decisions—and logical procedure—require a comparison in the light of the (admittedly valid) patent claim. Thus, in *McCullough, supra*, what the District and Circuit Courts actually did was to compare the accused product with the claims of the patent (at p. 234). Likewise, in *Siebring, supra*, what the District and Circuit Courts actually did was to compare the accused product with the patent claims (as well as the enjoined product in the context of the patent) (at p. 479). The decision in *Hopp Press, supra*, probably because it concerns issues of contributory infringement involving only a sub-combination of the claim, does not explicitly state the extent to which the question of colorable difference was referred to the patent claim. But the published decision suggests that the finding of merely colorable difference was made within the context of the sub-combination portion of the patent claim.

All of the cases cited by the Third Circuit explicitly hold that the *validity* of the patent ceases to be an issue after a consent decree. But none of them hold that the *patent claim* ceases to be relevant. Only the Third Circuit so holds.

3. The Third Circuit Is In Clear Conflict With The Decisions Of This Court.

The Third Circuit overlooked the following clear principles of law enunciated in the decisions of this court:

(a) The Third Circuit has improperly applied the doctrine of "equivalents" to adjudicate Trans Tech in contempt. In *Graver v. Linde*, 339 U.S. 605 at 608 and 609, this court stated that the question of equivalents "must be determined against the context of the patent, the prior art, and the particular circumstances of the case." The Circuit Court egregiously violated two, if not all three, of the ingredients comprising this rule. First, it purposefully *ignored* the patent in its determination that one disposable cover is the equivalent of the two disposable covers essential to the patent. Second, it purposefully *ignored* the prior art of transfer devices in which it was commonplace to apply all sorts of items mounted on a *single* removable sheet to all sorts of surfaces; this was a crucial error, as such prior art made it impossible for Barnard to obtain a patent on *one* removable sheet–the very product held by the Third Circuit to constitute contempt! Third, the circumstances of the case clearly demonstrated that the accused product entirely omitted one of the claimed elements of the Barnard Patent (a second detachable sheet), which claimed element was also present in the adjudicated infringing product.

(b) The doctrine of "file wrapper estoppel" barred these respondents from claiming patent rights in a defroster kit mounted on a single sheet. This court, in *Graham v. John Deere*, 383 U.S. 1 (1966), held that "claims that have been narrowed in order to obtain issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent," 383 U.S. 33. Even if the Third Circuit's conception and application of the doctrine of equivalents were correct, it is manifest under the principle of "file wrapper estoppel" that where a patentee has waived a specific claim, that patentee cannot later assert that claim under any theory.

(c) The decision of the Third Circuit is contrary to estab-

lished patent law as announced by this court in *Gage v. Herring*, 107 U.S. 640, 648 (1883), that where an essential element of a patent is omitted, there can be no infringement of such patent. A necessary corollary to this rule is that where an essential element of a patent claim contained in an admittedly infringing product has been omitted from the accused product, there can be no finding of contempt *or* infringement.

(d) The Third Circuit's finding of contempt is in clear conflict with this court's decision in *Terminal R. Assn. v. U.S.*, 226 U.S. 17 (1924), which held:

> "In contempt proceedings for its enforcement, a decree will not be expanded by implication or intendment beyond the meaning of its terms when read in light of the issue and the purposes for which the suit was brought; and the facts found that must constitute a plain violation of the decree so read." 266 U.S. 29.

The consent decree explicitly enjoined infringement and implicitly enjoined use of the Wolf product (because it was admitted that it infringed). The Trans Tech product clearly did not infringe, and omitted an essential patent element from the admittedly infringing Wolf product. The Third Circuit's decision that the Trans Tech product was nevertheless in contempt expands the language of the decree beyond any fair or rational "implication or intendment." To hold a party in contempt of a decree which he cannot reasonably anticipate to prohibit his act, cannot be due process of law.

4. A Comparison Of The Accused Product To The Infringing Product In The Context Of The Patent Requires Affirmance Of The Judgment Of The District Court.

The District Court made an initial determination that the accused product was sufficiently different from the admittedly infringing product to bar a summary contempt proceeding as a proper procedure. Appendix A (a-9). The District Court then

made provision for discovery and held a plenary hearing on the issue of whether the accused product infringed any claim of the patent (*Id.*). Following such plenary hearing, the District Court held:

> "The new Trans Tech product differs significantly from that which the Barnard Patent can legitimately assert to fall within the scope of its claims. It differs in that a pair of conductors, not in final configuration, are attached to a single sheet instead of being mounted between two sheets having different characteristics." Appendix A (a-6).

In sum, the District Court found two significant differences between the accused product and the patent claim, viz: (1) the patent covered a rear window defogger in its complete and final configuration while the accused product consisted of two parallel electrical conductors which could be used to design a final configuration, and (2) the complete array covered by the patent required two disposable sheets which sandwiched the array prior to its final application to the car window, while the accused product consisted of two parallel conductors attached to but a single disposable sheet prior to application.

We assume for the sake of argument that the first significant difference, *i.e.*, the absence of a final configuration, was foreclosed by the admission in the consent decree that the Wolf product infringed the patent. That is to say, that since the Wolf product did not consist of a final configuration but only two conductors sandwiched between two disposable sheets, vis-a-vis the parties, the consent decree in effect expanded, or admitted coverage by, the patent of two electrical conductors sandwiched between two sheets without a final configuration. That leaves the question of whether the second significant difference found by the District Court, *i.e.*, mounting on a single sheet rather than between two sheets, renders the accused product more than colorably different from the admittedly infringing product (*and* the patent).

The Third Circuit's facile answer to that question is that there is no colorable difference between the two because the one sheet involved in the accused product was the "equiva-

lent" of the two sheets in the admittedly infringing product. The Third Circuit reasoned that one sheet equals two sheets because in a roll, the reverse side of the one sheet is used to protect the electrical conductors in the same way that the second sheet in the admittedly infringing product was used to protect the conductors.

The "test" of equivalents applied by the Third Circuit was to determine whether the two sheets and the single sheet in a roll,

> ". . . do the same work in substantially the same way, and accomplish substantially the same result. . . ." Appendix B (a-23).

Although the quoted language appears in numerous decisions, including those of this court (*e.g., Graver v. Linde, supra,* at page 608), it was never intended that the abstraction represented by such language should be the ultimate test of equivalents without reference to such matters as the prior art or the patent claims involved. If the quoted language were the test, human imagination would be the only limit to the number of things that might be equivalent. For instance, if the work to be done is to keep a spring door from closing, the insertion between the door and the door frame of a typewriter, a radio, a television set, or any other conceivable object which fits between the door and the frame, and has sufficient strength to withstand the pressure of the spring, would all be equivalent.

The quoted abstraction may be a conceptual starting point but it clearly could not be the ultimate test. In *Graver v. Linde, supra,* this court stated:

> "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an abstract to be considered in a vacuum. It does not require complete identity for every purpose and in every respect. In determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes be equivalent. Consideration must be given to the purpose

> for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform." (P. 609).

The District Court has stated that the comparison of the adjudicated Wolf product (two strips) and the accused Trans Tech product (single strip in a roll) is akin to comparing a jelly sandwich to a jelly roll.[3] In a vacuum, the question of whether a jelly sandwich and a jelly roll are equivalent defies rational determination. To determine that issue as an abstract proposition is equivalent to tossing a coin. In effect, that is what the Third Circuit has done.

In the only logical context—the patent claim itself—it is clear that one sheet does not equal two sheets. The crux of the Barnard Patent is that the electrical elements are sandwiched between two *disposable* sheets. Indeed, the patent file wrapper demonstrates beyond any peradventure that Barnard was refused the patent which provided for the mounting of the electrical elements on a single disposable sheet. In *that context*, logic requires the conclusion that one sheet does not equal two. Accordingly, the ultimate result reached by the District Court, a result entirely consistent with the rule laid down in all circuits but the Third, was preeminently correct. The Third Circuit's conclusion that one sheet was the equivalent of two

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[3] District Court Judge Biunno used this analogy in his most recent decision of September 14, 1981 involving the parties to this proceeding after remand by the Third Circuit. *See* Appendix K (a-55). This latest proceeding dramatically demonstrates the unwarranted extension of a patent's scope through use of the Third Circuit's novel application of the doctrine of equivalents. In the latest proceeding before the District Court, Trans Tech, in an effort to maintain its economic viability, developed a rear window defogger kit that did not use any type or cover or transfer sheet. Instead, the new product consisted of two heating elements coiled inside a dispenser. The two coils of elements were unrolled horizontally in parallel lines directly from the dispenser onto the car window. Adhesive on one side of the heating elements caused them to adhere to the window surface. Trans Tech requested a declaratory ruling from the District Court that this latest kit did not violate the consent decree of September 6, 1978. Despite the fact that there were no detachable strips or sheets on this device, Judge Biunno felt that the decision of the Third Circuit required him to hold that the new product would be in contempt.

could only be reached by totally disregarding the only context which could lead to a reasonable determination of the issue—the underlying patent claim.

Conclusion

In entering into a consent decree, Trans Tech had explicitly agreed not to infringe the Barnard Patent and had implicitly agreed not to manufacture the Wolf product. The consent decree did not prohibit Trans Tech from manufacturing rear window defoggers that utilized electrical heating elements affixed to the rear windows. Nevertheless, the Third Circuit, solely on the basis of a comparison of products as reflected in the record, without reference to prior art and the scope of the claims of the patent, adjudicated Trans Tech in contempt for doing that which was not prohibited. Apart from the undeserved financial loss to Trans Tech and its stockholders, the consequences of the Third Circuit's decision as judicial precedent offends due process. Unless courts refer to the patents themselves, all consent infringement judgments will hereafter be vague and uncertain mandates. In the interest of proper administration of justice, and by reason of the public importance in striking down invalid exercises of patent rights, it is respectfully requested that this court grant this petition for review.

Respectfully submitted,

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APPENDIX

Appendix A, Opinion of District Court for the District of New Jersey dated January 21, 1980.

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW JERSEY
Civ. 78-647

Interdynamics, Inc., et al., Plaintiffs,

vs.

Firma Wolf, et als., Defendants.

OPINION

The complaint here was filed March 30, 1978, based on a claim of infringement of U.S. Patent 3,757,087, issued September 4, 1973 to Domenic Paul Edmund Barnard (hereafter, the Barnard patent or the '087 patent), and assigned to Smiths Industries, Limited (of London, England). Interdynamics holds the rights to the patent for the U.S.

The defendants are Firma Wolf, a Dutch corporation based in Rotterdam, Arend Wolf, an individual who is a resident and citizen of Holland, and Trans Tech, Inc., a New Jersey corporation based in Saddle River.

The Barnard patent covers a device designed to be attached to the inner surface of the rear window of an automobile, so constructed that by the application of voltage from the electrical system a current will flow and generate heat. This heat has the useful function of defrosting or defogging the rear window of the car under conditions of snow, ice or condensation.

Although nothing in the disclosure or claims so restricts it, the record is clear that the Barnard device is mainly intended for what may be called the "after market", i.e., to supply a device for rear window defrosting and defogging to the owners of cars purchased without such a feature. In principle, it could presumably be used as a means to provide original equipment by the auto manufacturer, but this does not appear to be its actual market.

Appendix A, Opinion of District Court for the District of New Jersey dated January 21, 1980.

Some brief history, noted in the record, may be observed as a matter of judicial notice. This history indicates that until relatively recent times, the manufacturers of the typical passenger car did not provide means for keeping the rear window clear of accumulations of ice, snow or condensation. In the post-war period, some manufacturers did offer, as an extra option, a rear-window defroster that made use of a fan to blow warm air along the inside surface, either employing a heating element within the blower (as in the common hair dryer) or else picking up air warmed by the car's heater and circulating it in concentrated fashion along the inner surface of the rear window. Such blower systems were also available on the accessories market, for installation by a mechanically apt owner or by a neighborhood service station.

Sometime around the later 1960's or very early 1970's manufacturers began offering electrically heated rear windshields to achieve the same purpose. So far as is known, such devices have always been, and are today, offered as optional extras. At the start, the approach used was to embed the thin heater wires within the glass of the rear window itself. Possibly due to the cost involved, the modern method is to apply stripes of electrically conducting paint to the inner surface of the rear window, probably by some glazing or bonding system, but in any event terminating in a wire connection running to a switch and then to the electrical supply (battery) of the car to provide the energy.

As the disclosure in the Barnard patent explains, devices had been made and marketed as automobile accessories which consisted of a pair of flexible, clear plastic sheets sandwiched together with a heating element between. Such devices could be attached to a rear window, as by rubber suction cups, and the terminals connected to a switch and the electrical supply. These devices suffered from various disadvantages, claimed to be

overcome by the Barnard patent, such as discoloration of the plastic sheet, or the accumulation of dust and grime on the inaccessible surfaces of the rear window and the plastic sheet which faced each other, and the like.

The novel feature of the Barnard patent, as the court reads its scope, is the providing of an intermediate and partially discardable device which can be employed to attach as electrical heating element to the inner surface of the rear window itself, in a fashion such that when the application is completed the only material attached to the glass is the heating element. The end result is thus much the same as the painted electrically conductive stripes furnished as an optional extra by automobile manufacturers.

The Barnard device accomplishes this by sandwiching the complete heating element, in the physical dimensions and array intended, between two removable sheets. One sheet is a protective cover only lightly attached which can be stripped away without disturbing the arrangement of the heater stripes on the second sheet. The heater stripes themselves, which appear to be a thin aluminum or alloy foil, are provided with an adhesive coating that from observation is "pressure sensitive", in that upon being applied to the rear window, will stick to it with more cohesion (i.e., more strongly) than the temporary bond between the stripes and the second or mounting sheet. The testimony also is that this adhesive, in addition to being pressure sensitive for the initial application, is also "thermosetting", in that it is cured or hardened by the application of heat when current is passed through the stripes.

Thus, the design is that the protective sheet is first removed. Then the exposed surface is applied to the inner surface of the rear window with suitable rubbing or other pressure to cause the heater element stripes to adhere to the glass. Then the

second or mounting sheet is stripped away, leaving the heater element, in its original configuration, attached to the rear window. After attaching wire connections to the switch and battery, the heater is ready for use.

At the time the complaint was filed, Trans Tech was marketing a competing product manufactured by Wolf in Holland and shipped here. That product simulated the Barnard product in that it was composed of a like "sandwich" consisting of a mounting sheet and protective sheet, with heater elements between. There the simulation ended because the Wolf product was made up of a pair of heater element stripes in a continuous roll, and not as a pre-arrayed, configurated rectangular defroster ready for application. A user of the Wolf device would be obliged, in effect, to assemble the complete configuration by applying a number of pairs of heater stripes to the rear window after cutting the roll to the requisite length, and then connecting the ends of the horizontally arrayed stripes with vertical conductors eventually leading to connectors for attachment to wires running to the switch and battery.

Trans Tech did not file an answer to the complaint. Instead, after some motions by the Wolf defendants to dismiss for lack of jurisdiction, the court was presented with a consent judgment, stipulated to by plaintiffs and by Trans Tech, conceding both validity and infringement and for entry of permanent injunction. This was filed September 6, 1978.

Thereafter Trans Tech began marketing a new product. An order to show cause to hold Trans Tech in contempt for violation of the permanent injunction was issued and a hearing thereon was held. Because of doubt in the court's mind whether the issue could be decided properly on a summary contempt proceeding, in view of differences between the admittedly infringing Wolf product and the new Trans Tech product, provision was made for discovery and plenary bearing and the

issue was tried in full on the question whether the new Trans Tech product infringed any claim of the Barnard patent.[1]

After full review of the testimony, exhibits and briefs submitted, the court concludes that the new Trans Tech product does not infringe any claim of the Barnard patent and that its conduct is not a violation of the permanent injunction entered by consent.

This finding and conclusion rests on the court's view that the scope of the claims of the Barnard patent is extremely narrow. The meaning of the English words in the claims cannot be read so broadly as to embrace within the patent monopoly anything already in the public domain. Old articles and known applications cannot achieve patent protection merely because of the addition of a novel and useful feature or variation. Only the novel and useful added feature or variation can come within a claim read in the context of the state of the art. [2]

The Barnard patent cannot be read to cover the basic concept, long known, that heat may be generated and applied to a surface by passing an electric current through a resistance. Ohm's Law, discovered by Georg Simon Ohm sometime before his death in 1854, states all the necessary principles. Six volts applied to one ohm will cause six amperes to flow. Within the conductor, the square of the current (6 x 6 = 36) times the resistance (1) provides the wattage generated (36 watts), easily converted into B.T.U. heat units by established formula. Twelve volts applied to two ohms will also cause six amperes of current to flow, but now the square of the current (36) times the resistance (2) provides twice the wattage (72) and twice the heat so long as all of the wattage is converted to heat, as is the case in this kind of device. In these examples, the much smaller resistance of the connecting wires is ignored. [3]

Appendix A, Opinion of District Court for the District of New Jersey dated January 21, 1980.

The common electric heating pad is a reflection of an application of Ohm's Law. So is the glass "hot tray", which also has an electrical resistance applied to the glass, to keep food and beverages warm.

Thus, the format of an electrical resistance, attached to a surface, with a voltage applied to generate heat to that surface, was long and well known in 1973 when the patent was issued, and in 1971 when the application was filed. Nothing of that breadth can possibly be read sensibly within the scope of the claims, no matter how broadly phrased.

As this court reads the Barnard patent, the most that can be read to fall within the scope of the claims is not the final product desired by the purchaser — an array of electrical resistance elements on the rear window of his car—but an intermediate device that will enable him to achieve that end result in a form embodying the complete configuration, prearrayed, and mounted between two sheets of material the purpose of one of which is to protect the delicate elements in handling and of the other of which is to protect the delicate elements in handling and of the other of which is to maintain the configuration and arrangement for mounting. [4]

Whether or not the Wolf product infringed the patent is not before the court. The parties stipulated that it did, and a judgment to that end was entered. It is not open to question between the parties. However, even if a court had found an infringement by the Wolf product after trial, it is clear that the Wolf product represented the outer boundary of infringement.

The new Trans Tech product differs significantly from that which the Barnard patent can legitimately assert to fall within the scope of its claims. It differs in that a pair of conductors, not in final configuration, are attached to a single sheet instead of being mounted between two sheets having different charac-

teristics. To argue that this product infringes the Barnard patent would amount to arguing that resistance wire and adhesive infringe. It would amount to a patent on Ohm's law for any application intended to generate heat on a surface by passing an electrical current through a resistance.

Exhibit C - 1, from a catalog of a supplier of automobile accessories for the "after market", illustrates the type of warm air blower defroster mentioned above as the earlier kind of device for rear windows, and still the primary type of defroster, working from the car's heater, that is still used for front windshields since any kind of stripe would involve a degree of interference with the forward vision of the driver. No doubt there are kinds of clear, transparent, electrically conductive glasses that could be used, in principle, to provide an electrical defroster and defogger for the front windshield. However, since internal combustion engines are notoriously inefficient and generate considerable waste heat from the combustion process and from friction, there is a considerable amount of available heat that must be dissipated through a cooling system, and it is no doubt more economical to divert some of that waste heat to defrost or defog front windshields than it would be to provide an electrical heater.

Exhibit C-4 is a roll of aluminum or alloy foil, in a strip, provided with a pressure sensitive adhesive in much the same fashion as the common mending tape of many manufactures. If the owner of a car wished to construct an electrical rear window defroster or defogger himself, the court sees nothing to prevent the use of such an electrically conducting tape, applied to the inner surface of a rear car window, to provide a suitable heating element for defrosting or defogging purposes by applying the battery voltage through a switch. See, also, Exh. C-2 and C-3 for other examples of tape rolls in forms that could be used in like fashion. Nor would such as application of a metallic conductor constitute an infringement of the Barnard patent un-

less it were possible to say that every application of a resistance to generate and apply heat to a surface would be an infringement. It is not possible to say that. The basic principle is too well known and too widely applied. Electrical resistances are known and available to place in gutters where they will prevent the formation of ice. They are available in runners to place over steps and walks to prevent the formation of ice or to dispose of accumulations of snow. They are available as tapes to wrap around water pipes that are subject to the risk of freezing in cold weather.

Given this context, it is plain that a sensible reading of the claims of the admittedly valid Barnard patent, as between these parties must be limited to a prearranged array of heating elements sandwiched between a protective sheet and a mounting sheet designed to preserve the manufactured configuration and array of the heating elements. It cannot be read to cover electrical conductors and adhesives which must not only be cut and assembled, but which are provided only with a mounting sheet and no separate protective sheet.

In sum, the Barnard patent is a modern variation of the old and well known decalcomania usually based on the use of gelatin and a water-soluble release adhesive as means for transferring a pre-determined array from a mounting sheet to a surface to which the object is intended to be applied. The new Trans Tech product does not reach that level. To say that it did would be to say that the Barnard patent would be infringed by a bottle of electrically conducting paint and a brush used to apply the paint to a rear car window in a suitable array to serve as a defroster and defogger by the application of an electrical voltage and the passing of a current to generate heat.

For each and all of these reasons, the court concludes and finds that the new Trans Tech product neither infringes any

claim, sensibly read, of the Barnard patent, nor violates the permanent injunction entered by consent in this case.

The foregoing opinion embodies the court's findings of fact and conclusions of law, as permitted by F.R. Civ. P. 52 (a).

Submit order accordingly.

January 21, 1980 s/ Vincent P. Biunno, U.S.D.J.

Original to Clerk
xc: Pitney, Hardin & Kipp, Esqs.
Kirsten, Friedman & Cherin, Esqs.
Leonard Frederick, Esq.

FOOTNOTES

[1] The cases which gave the court concern whether it could rule on the new Trans Tech product in a summary contempt hearing were referred to in the transcript of the November 13, 1978 hearing and need not be repeated here. Suffice it to say that the question whether the new device is only colorably different from the previously enjoined device or from the patent was rendered moot by the procedure of allowing relevant discovery and a plenary hearing in the cause. This avoided burdening Interdynamics with the filing of a new suit, yet provided Trans Tech with more than a summary hearing. At the end, the controlling question then is whether the new Trans Tech device infringes any claim of the patent. If it does, then it would also support a finding of contempt.

[2] That a patent combining a number of features cannot achieve monopoly for those features already known in the prior art and in the public domain is obvious. It is for this reason that the claims of such a patent must be read in that context. File wrapper history showing rejection of a submitted claim as anticipated by prior art is strong evidence to aid the court in construing the patent and determining the scope of the claims. See, *Graham v. John Deere, etc.*, 383 U.S. 1 (1966). The record here shows that claims originally submitted were for an intermediate with only the heater elements, adhesives, and a mounting sheet, but with no protective sheet to make a sandwich. That claim would cover the new Trans Tech

device (except that it was for a completely formed array), but it was rejected.

[3] The laws governing the electrical resistance of metallic conductors are and have been well and long known. These are:

> 1. *Material.* All other conditions being the same, each metallic material has its own unique resistance, which is the reciprocal of conductance. Thus, for a wire 1/1000th inch in diameter and one foot long (a mil foot), the following resistance in ohms is characteristic of the materials shown below.
>
> | | |
> |---|---|
> | Silver, 9.76 ohms | Platinum, 58.80 ohms |
> | Copper, 10.38 ohms | Iron, 63.08ohms |
> | Aluminum, 19.00 ohms | German silver, 135.92 |
>
> 2. *Area.* This refers to the cross section area of a conductor of uniform dimensions. The resistance is inversely proportional to the cross section area. Thus, doubling the cross section area reduces the resistance to 1/2.
>
> 3. *Length.* The resistance of a conductor is directly proportional to its length. Ten feet of a given conductor will show 10 times the resistance in ohms as one foot of the same conductor.
>
> 4. *Temperature.* The resistance of metallic conductors increases as its temperature rises.

See, Essentials of Physics, by George A. Hoadley (American Book Company, 1913), par. 391, at pp. 354 to 356. This collection of rules is commonly taught to high school students by the acronym "MALT", referring to *M*aterial, *A*rea, *L*ength and *T*emperature.

The laws governing the generation of heat by the passage of electrical current through a conductor are derived from Ohm's Law. This law states that for a given conductor, the current (in amperes) is directly proportional to the electromotive force (in volts) and inversely proportional to the resistance (in ohms). It is usually written as I= E/R, where I is amperes, E is volts and R is ohms.

Appendix A, Opinion of District Court for the District of New Jersey dated January 21, 1980; (Not reported.)

The rule for power consumed, in watts, is derived from Ohm's Law. By algebraic conversion, the voltage drop E across a resistance is equal to the current (in amperes) times the resistance (in ohms). That is, since I = E/R, then E= IxR. Since power consumption (in watts) is the product of the voltage times the current, the equivalent I x R may be substituted for E, resulting in the formula I x I x R, or $I^2 R$ = watts of power. See Hoadley, supra, par. 393 at p. 357, and par. 401-402 at pp. 362-363. Any other good high school physics text will provide the same explanations.

As should be obvious, the generation of heat in this fashion represents a loss of energy when the object is to transmit a current from a power source to an appliance. The heat loss is useful, however, when it is generated for the purpose of applying the heat to some desired end. See, Hoadley, supra, par. 402 at p. 363, giving examples of various kinds of electric heaters.

[4] Interdynamics argues vigorously that the doctrine of equivalents should control here. The argument is that when packaged in a roll, one surface of the plastic strip serves to support the aluminum stripes while the rear surface serves to protect those stripes on the next turn of the coil. Whatever the legitimate applications of that doctrine may be, the court is satisfied that none prevents a competitor from marketing a device which combines only features in the public domain and makes no use of a feature possessing the novelty and utility essential to validity. Where that novel and useful feature is omitted, as here, the doctrine cannot be relied on to draw in to the scope of the claims that which was in the public domain to begin with.

Appendix B, Opinion of The Third Circuit Court of Appeals filed June 30, 1981 (653 F.2d 93)

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 80-2254

INTERDYNAMICS, INC., and
SMITHS INDUSTRIES, LIMITED,

Appellants

v.

FIRMA WOLF, AREND WOLF, and
TRANS TECH, INC.

ON APPEAL FROM THE UNITED STATES DISTRICT
COURT FOR THE DISTRICT OF NEW JERSEY

(Civ. No. 78-647)

Argued March 23, 1981

Before: HUNTER, SLOVITER and WISDOM*,
Circuit Judges

(Filed June 30, 1981)

S. Joseph Fortunato
Pitney, Hardin & Kipp
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*Hon. John Minor Wisdom, United States Court of Appeals Judge for the Fifth Circuit, sitting by designation.

Appendix B

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OPINION OF THE COURT

SLOVITER, *Circuit Judge*

Interdynamics, Inc. and Smiths Industries, Ltd. appeal from an order of the district court holding that the sale by defendant Trans Tech, Inc. of an automobile rear-window defroster kit was not a contempt of a consent decree entered in a prior infringement action between the same parties. As part of that consent decree

appellees admitted the validity of the patent on which suit was brought and admitted that they had sold a defroster kit that infringed that patent. When Interdynamics applied for a contempt order based on Trans Tech's subsequent sale of a modified kit, the district court found that the new kit did not infringe the patent and refused to find a contempt. Because the district court applied an incorrect legal standard in deciding the question of contempt, we reverse and remand.

I.

Appellant Smiths Industries, a British corporation, owns a patent (Barnard U. S. Patent No. 3,757,087) for an automobile rear-window defroster. Appellant Interdynamics, Inc. is the United States licensee for the patent, markets the kit described in the patent, and has the right to sue for its infringement. This kit consists of a grid of metal heating strips sandwiched between a backing sheet and a top sheet of plastic. Installation of the defroster simply entails peeling off the backing sheet and placing the exposed strips and adhesive surface of the top sheet against the car window. The adhesive that covers the surface of the heating strips which contacts the glass is stronger than the adhesive attaching them to the top sheet on which they lie. Thus, when pressure is applied to the top sheet over the heating strips, the strips adhere to the window and the top sheet can be peeled away. This process leaves only the grid of heating strips on the surface of the window. This grid is then connected to the automobile's electrical system and heat can be generated by passing electricity through the heating elements.

Appellee Firma Wolf, a Dutch corporation owned by appellee Arend Wolf, developed a similar kit in Europe and sold it in the United States through appellee Trans Tech. The Wolf product differed from the Interdynamics kit in that the Interdynamics kit contains a single set of

sheets supporting a full pre-arrayed grid of heating strips, while the Wolf product contained four sets of sheets. Each set in the Wolf product consisted of a backing sheet and a top sheet, between which were sandwiched two parallel heating strips also containing adhesives of different strengths. The sheets were long and narrow, and were packaged in coils. Installation of each set was performed as in the Interdynamics kit, except the four sets of heating strips had to be linked together as well as to the electrical system.

In March 1978 Interdynamics and Smiths filed an infringement action against Trans Tech, Arend Wolf, and Firma Wolf. At Trans Tech's instigation, a settlement was reached providing for a consent decree which was entered in that action on September 6, 1978. That decree provided in part:

> 2. Barnard United States patent 3,757,087 for HEATING ELEMENTS, owned by plaintiff Smiths Industries, Limited and solely licensed to plaintiff Interdynamics, Inc., is both good and valid in law and is enforceable;
>
> 3. Defendant Trans Tech, Inc. has infringed Barnard United States patent 3,757,087 by using and selling rear window defrosters identified with the trademark "JUSTLIKE" and manufactured by defendant Firma Wolf under the direction and control of defendant Arend Wolf.

Trans Tech agreed that it and those in privity with it should be permanently enjoined from infringing any claim of the patent. Pursuant to the settlement agreement, Interdynamics waived damages and gave Trans Tech the right to dismantle kits remaining in its inventory.

Soon after entry of the consent decree, Trans Tech began to market a modified version of the Wolf product, referred to by the parties as the Trans Tech product. In this product, the four coils did not contain separate top

and backing sheets but were instead constructed in continuous rolls, much like rolls of conventional adhesive tape. The smooth back of each layer of plastic sheet served as the protective surface for the heating strips and adhesive surface in the layer above. Thus the need for a separate covering sheet was eliminated. The Trans Tech product was otherwise identical to the Wolf product.

In November 1978 Interdynamics applied for an order to show cause why Trans Tech should not be held in contempt for violating the consent decree and moved for an injunction against sale of the Trans Tech product. After a hearing later that month, the court stated that it would not reconsider whether the Wolf product was within the patent or whether the patent was valid. However, it concluded that it could not decide whether the Trans Tech product was a contempt until it had held a full trial on whether the Trans Tech product infringed the patent.[1] The court scheduled a new hearing on the

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1. The court, at one point during the hearing, stated that the question under the applicable case law was whether the new device was "merely colorably different from the enjoined device or from the patent claims":

> [A] term like colorably different is a variable. It all depends on where the infringing product stood on the scale, let us say, of variables *in relation to the patent* and in relation to whatever divides the patent from those things which are outside of the scope. There are boundaries to every patent. If the original infringing device is, essentially, identical or, let us say, near the center of the area encompassed by that boundary, then, a new device would need be quite different, presumably, to fall outside the boundary.
>
> On the other hand, where the infringing device itself, although infringing, is near the boundary line of the scope, then, a much smaller difference may suffice to take the new product outside the boundary of the scope. (emphasis added)

In fact, at the continued hearing the court undertook the inquiry which is utilized in infringement cases by comparing the product to the patent claims instead of the inquiry appropriate to contempt pro-

question of infringement, albeit emphasizing that these proceedings were a continuation of the prior action and not a new action for infringement.

Following the hearing on infringement, the court found that the Trans Tech product did not infringe the patent and was thus not a violation of the consent decree. The court stated that while it would not reconsider whether the Wolf product infringed the patent, which question had been determined in the consent decree, "it is clear that the Wolf product represented the outer boundary of infringement." The Trans Tech product, it found, differed significantly from that which the "patent can legitimately assert to fall within the scope of its claims." The Trans Tech product used heating strips "not in final configuration" and not "mounted between two sheets having different characteristics." The court stated that "[t]o argue that this product infringes the Barnard patent would amount to arguing that resistance wire and adhesive infringe," and concluded that the Trans Tech product neither infringed the patent nor violated the permanent injunction.

On appeal, Interdynamics contends that the district court erred in analyzing the question of contempt in this case as one of infringement in which the challenged Trans Tech product was compared with the claims of the patent. Interdynamics argues that the proper analysis of a claim of renewed infringement after entry of a consent decree requires, instead, comparison of the new product with the product previously admitted to be in-

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NOTE — (*Continued*)
ceedings, which involves a comparison between the product previously admitted to infringe and the modified product at issue. *See* Siebring v. Hansen, 346 F.2d 474, 477 (8th Cir.), *cert. denied*, 382 U.S. 943 (1965); Hopp Press, Inc. v. Joseph Freeman & Co., 323 F.2d 636, 638 (2d Cir. 1963). Appellee does not contend that the trial court made a product to product comparison, but claims instead that the issue of colorable difference is inseparable from the issue of infringement.

fringing. Only if the two are more than "merely colorably different" is there any need for further inquiry. Interdynamics argues also that assuming arguendo the question of infringement is relevant, then the Trans Tech product is infringing. Trans Tech and the other appellees respond that the district court properly undertook to determine whether the Trans Tech product infringes the Barnard patent. Because it does not infringe, they conclude, it cannot constitute a contempt of an injunction against infringement.

II.

This court has not previously considered what course should be followed by a court which has entered a consent decree in an infringement action, after which the infringer begins to sell a modified version of the infringing product. Analysis must proceed along the path provided by established legal principles. In the first place a consent decree, although negotiated by the parties, is a judicial act. *United States v. Swift & Co.*, 286 U.S. 106 (1932). Such a decree possesses the same force with regard to res judicata and collateral estoppel as a judgment entered after a trial on the merits. See generally, *Harding v. Harding*, 198 U.S. 317 (1905); *Burgess v. Seligman*, 107 U.S. 20 (1882). In patent cases as well, consent decrees entered in settlement of an infringement action are entitled to res judicata effect. *See Brunswick Corp. v. Chrysler Corp.*, 408 F.2d 335, 337-38 (7th Cir. 1969); *Siebring v. Hansen*, 346 F.2d 474, 477 (8th Cir.), *cert. denied*, 382 U.S. 943 (1965).

This leads, then, to the second step which is that a party violating a consent decree may be subject to the powers by which a court protects its judgments, including most notably the power of contempt under 18 U.S.C. §401 (1976). This section provides:

> A court of the United States shall have power to

> punish by fine or imprisonment, at its direction, such contempt of its authority, and none other, as -
>
> . . . .
>
> (3) Disobedience or resistance to its lawful writ, process, order, rule, decree, or command.

See *United States v. Armour & Co.*, 402 U.S. 673 (1971); *McCullough Tool Co. v. Well Surveys, Inc.*, 395 F.2d 230 (10th Cir.), *cert. denied*, 393 U.S. 925 (1968) (patent infringement decree); *Siebring v. Hansen*, 346 F.2d at 477 (patent infringement decree). Since failure to obey a court judgment is an indirect contempt, notice by an order to show cause and a plenary hearing are appropriate. *See, e.g., Leman v. Krentler-Arnold Hinge Last Co.*, 284 U.S. 448 (1932) (patent). *See also* Dobbs, *Contempt of Court: A Survey*, 56 Cornell L. Rev. 183, 224 & n.162 (1971). This procedure was followed by the district court in this case.

The central issue presented in such cases, however, is what legal and factual issues are before the court at such a hearing. When the consent decree admitted both validity and infringement, a defendant may not reopen the issue of whether the product previously admitted to infringe did in fact infringe. This preclusion follows from the prior admission, which has the effect of an adjudication. It must also follow that the validity and scope of the plaintiff's patent may not be reopened in the subsequent contempt proceedings, since this issue is equally foreclosed by the prior admission. *See Siebring v. Hansen*, 346 F.2d at 477, and cases cited therein. *See also* Note, *"To Bind or Not to Bind": Bar and Merger Treatment of Consent Decrees in Patent Infringement Litigation*, 74 Colum. L. Rev. 1322, 1334 (1974).

It may be that because these principles are well established, courts are rarely confronted with alleged contempts based squarely on adjudicated products. It is far more likely that the product at issue in the subse-

quent proceeding will be in some manner a modified version of the adjudicated product. In such a situation, the court must decide whether to treat the inquiry as one of infringement *de novo*, in which the issue of patent validity and scope may be raised, or whether a more limited inquiry is called for. Two somewhat conflicting concerns are implicated.

On one hand, support for allowing a party to raise the defense of invalidity of the patent after having previously admitted its validity may be found in the policies underlying the decision in *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969). There the Court held that federal patent policies may demand litigation of validity even where parties had entered into a contractual relationship precluding such litigation. *Id.* at 670-71. Furthermore, testing every modified product of an adjudicated infringer in contempt proceedings "would unnecessarily deter parties from marketing new devices that are legitimately outside the scope of the patent in question." *McCullough Tool Co. v. Well Surveys, Inc.*, 395 F.2d at 233.

On the other hand, if a patentee could only attack each modified product in a new infringement action, no matter how minimal the modification, such a requirement would significantly diminish the force of a consent decree as a judgment of the court. *Id.* In each new action, the patentee would be put to the expense of reestablishing the scope of its patent and the patent's congruence with the allegedly infringing product. If these essential aspects of a patentee's rights could be reopened at the option of an infringer, patentees would lack incentive to enter into settlements. Moreover, there would result a "subversion of the deeply instilled policy of settlement of legitimate disputes . . . ." *Ransburg Electro-Coating Corp. v. Spiller & Spiller, Inc.*, 489 F.2d 974, 978 (7th Cir. 1973) (enforcing a contractual settlement of an infringement suit). This could lead to more litigation because infringers would have an incentive to

enter a consent decree and attempt to relitigate issues in a contempt proceeding. *Schlegel Mfg. Co. v. USM Corp.*, 525 F.2d 775, 782 (6th Cir. 1975), *cert. denied*, 425 U.S. 912 (1976). Such relitigation would frustrate the general public interest in finality of litigation, and in vindicating judicial authority. *See United States ex rel. Shell Oil Co. v. Barco Corp.*, 430 F.2d 998, 1002 (8th Cir. 1970).

These concerns in protecting settlements have led courts faced with a prior consent decree in a patent infringement action to place their principal reliance on effectuating the doctrine of res judicata. The decision in *Lear, Inc. v. Adkins, supra*, has been held inapplicable. As one court noted:

> No consent decree was even involved in *Lear* . . . . [*Lear's*] derogation of contract law in favor of patent law is a far cry from allowing identical parties to reopen valid judicial [consent] decrees at their mere whim . . . . In the case of a consent decree, . . . we only look to the equities involved as to the particular parties and the public interest is not at stake.

Schlegel Mfg. Co. v. King Aluminum Corp., 369 F.Supp. 650, 652 (S.D.Ohio 1973). *See also Wallace Clark & Co. v. Acheson Industries, Inc.*, 394 F.Supp. 393 (S.D.N.Y. 1975).

The significant public interest represented by the doctrine of res judicata requires that where a prior consent decree between the same parties admitted validity of the patent, in a subsequent proceeding the court must focus on the products rather than on the patent itself. Thus the appropriate inquiry is whether the new product alleged to be a contempt is "merely colorably different" from the product previously conceded to infringe. *See, e.g., McCullough Tool Co. v. Well Surveys, Inc.*, 395 F.2d at 233; *Siebring v. Hansen*, 346 F.2d at 477; *Hopp Press, Inc. v. Joseph Freeman & Co., Inc.*, 323 F.2d 636, 638 (2d Cir. 1963).

This was not the inquiry undertaken by the district court in this case. As noted in note 1, *supra*, instead of comparing the product which was the subject of the consent decree with the product which Trans Tech was then distributing, the court undertook to inquire whether the Trans Tech product infringed the Barnard patent.[2] The court treated the proceeding as a *de novo* infringement proceeding, thereby depriving plaintiff of the benefit of the prior decree in which plaintiff waived its right to damages for Trans Tech's admitted infringement by the distribution of the Wolf product. The correct procedure would have been for the court to have determined whether there were merely colorable differences between the Wolf product, which admittedly infringed the Barnard patent, and the Trans Tech product.[3]

III.

In determining whether the changes made by the Trans Tech product were merely colorably different and therefore a contempt, it is necessary to apply the well-established doctrine of equivalents. *Simmons Co. v.*

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2. The district court believed that Minerals Separation, Ltd. v. Miami Copper Co., 269 F. 265 (3d Cir. 1920), authorized an ancillary proceeding to determine whether a new product infringes a patent. In that case, the court stated that the remedies against infringement after decree are "damages and profits on accounting, attachment for contempt, and original bill." *Id.* at 268. We do not view that statement as inconsistent with the holding in this case, since that court had at the beginning of the opinion concluded that the district court correctly held that the modifications were not mere colorable equivalents of the patent in question. *Id.* at 267. In any event, the only matter appropriately before the court was whether the district court had abused its discretion in denying a supplementary injunction.

3. The patent is not thereby insulated from attack. Such challenge, however, must come from a party who has not previously admitted the patent's validity and scope, and submitted itself to a judicial decree embodying that admission.

A. Brandwein & Co., 250 F.2d 440, 450 (7th Cir. 1957). This doctrine has been described by the Supreme Court as follows:

> [I]f two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape.

Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 608 (1950).

Reliance on the doctrine of equivalents to determine whether the new product is merely of "colorable difference" will protect the plaintiff's right to the benefit of the prior decree while at the same time reserving to the defendant the opportunity to take a new route to invent around the patent it has infringed. Even if the new product may infringe the patent, as long as it is more than "colorably different" the infringement should not amount to a contempt nor should it be tested in contempt proceedings. *Siebring v. Hansen*, 346 F.2d at 477.

Applying that doctrine in this case, it is necessary to compare the Trans Tech product with the Wolf product to determine the significance of the presence or absence of a separate backing sheet. Because this turns on the exhibits in the record and on uncontroverted evidence, without the need for credibility assessments or other special evaluation by the district court, we may decide the issue without remand. *See Hopp Press, Inc. v. Joseph Freeman & Co.*, 323 F.2d at 637.[4]

From our examination of the record, we conclude that the change in the structure of the coiled sheets between the Wolf and the Trans Tech products did not omit any function of the Wolf product. The same work (protecting the heating strips) was done in precisely the

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4. Counsel for appellee stated at oral argument before us that there is enough in the record for this court to make the decision on the issue of "colorable difference."

same way (by covering with a low adhesion surface) to accomplish the same result (installation of a defroster). The change between the two products seems, on this record, to produce no greater efficiencies, and to omit or alter no function. Without deciding what constitutes the outer boundary of what is "merely colorable," it is clear to us that the Trans Tech product is within that boundary.[5]

IV.

For the reasons set forth above, we will remand this case to the district court so that it may enter a judgment of contempt against Trans Tech, and for such further proceedings as may be necessary.

A True Copy:

Teste:

Clerk of the United States Court of Appeals for the Third Circuit

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5. In view of our disposition of this matter, we do not decide whether the Trans Tech product infringes the Barnard patent. The district court decided that it did not because it found the Trans Tech product lacks the Barnard product's prearranged array of heating elements. We note that appellees do not place their principal reliance on that purported distinction, possibly because of their recognition that the spatial relationship between the heating elements in the Trans Tech product does not differ from that of the Wolf product, which they had previously admitted infringed the Barnard patent.

Appendix C. Judgment of the Third Circuit Court of Appeals filed June 30, 1981 for which review is sought

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 80-2254

INTERDYNAMICS, INC. AND SMITHS INDUSTRIES, LIMITED,
Appellants
vs.
WOLF, Firma, AREND WOLF AND TRANS TECH, INC.

(D.C. Civil No. 78-00647)

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE – DISTRICT OF New Jersey

Present: HUNTER, SLOVITER, and WISDOM,*, Circuit Judges

JUDGMENT

This cause came on to be heard on the record from the United States District Court for the – District of New Jersey and was argued by counsel on March 23, 1981.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court, entered July 7, 1980, be, and the same is hereby reversed and the cause is remanded for further proceedings in accordance with the opinion of this Court. Costs taxed against appellee.

ATTEST:

June 30, 1981 Clerk

*Hon. John Minor Wisdom, United States Court of Appeals Judge for the Fifth Circuit, sitting by designation.

Appendix D, Order of The District Court for the District of New Jersey made July 3, 1980

U.S. DISTRICT COURT - DISTRICT OF NEW JERSEY

Civ. No. 78-647

Interdynamics, Inc., et al., Plaintiffs,

v.

Firma Wolf, et als., Defendants.

ORDER

This matter having come before the Court on Order to Show Cause why defendant Trans Tech, Inc., should not be held in contempt for violation of the permanent injunction filed herein September 6, 1978, and

The court having conducted plenary hearing on the question whether said defendant's later marketed product infringed any claim of the patent dealt with by said permanent injunction and, if so, whether the same constituted contempt; and

The court having handed down its Opinion thereon under date of January 22, 1980 with direction to submit order accordingly; and

No order having been submitted pursuant to said Opinion;

It is, on this 3rd day of July, 1980, for the reasons set forth in the Opinion dated January 22, 1980, ORDERED THAT:

1. The product of defendant Trans Tech, Inc., consisting of two parallel, narrow, flat strips of metal foil, said foil being and electrical resistance and conductor such as to generate heat upon the passage through it of an electrical current, and said strips being mounted on a backing strip by means of a "release" type of adhesive, and being coated on their exposed surfaces with a pressure-sensitive adhesive of a tremosetting

nature, the said backing strip being coiled into a roll without the use of a separate protective strip covering the foil, does not infringe any claim of said patent.

2. The said product does not violate the permanent injunction herein signed September 6, 1978.

s/ Vincent P. Biunno, USDJ

Appendix E, Order of The Third Circuit Court of Appeals dated July 23, 1981 denying petition for rehearing

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 80-2254

INTERDYNAMICS, INC. and SMITHS INDUSTRIES, LIMITED,

Appellants

v.

WOLF, FIRMA, AREND WOLF and TRANS TECH, INC.,

Appellees

SUR PETITION FOR REHEARING

Present: SEITZ, Chief Judge, ALIDSERT, ADAMS, GIBBONS, HUNTER, WEIS, GARTH, HIGGINBOTHAM, SLOVITER, and WISDOM*, Circuit Judges

The petition for rehearing filed by Trans Tech, Inc., appellee,

in the above entitled case having been submitted to the judges who participated in the decision of this court and to all the other available circuit judges of the circuit in regular active service, and no judge who concurred in the decision having asked for rehearing, and a majority of the circuit judges of the circuit in regular active service not having voted for rehearing by the court in banc, the petition for rehearing is denied.

Judge Garth would grant the petition for rehearing.

By the Court,

s/ Dolores K. Sloviter
Circuit Judge

Dated: July 23, 1981

*Hon. John Minor Wisdom, United States Court of Appeals for the Fifth Circuit, sitting by designation.

Appendix F:
Section 401, Title 18, United States Code
Section 2106, Title 28, United States Code
Rule 52 (a), Federal Rules of Civil Procedure
Rule 65 (d), Federal Rules of Civil Procedure

Sec. 401. Power of Court

A court of the United States shall have power to punish by fine or imprisonment, at its discretion, such contempt of its authority, and none other, as –

(1) Misbehavior of any person in its presence or so near thereto as to obstruct the administration of justice;

(2) Misbehavior of any of its officers in their official transactions;

(3) Disobedience or resistance to its lawful writ, process, order, rule, decree, or command. June 25, 1948, c. 645, 62 Stat. 701.

Sec. 2106. Determination

The Supreme Court or any other court of appellate jurisdiction may affirm, modify, vacate, set aside or reverse any judgment, decree, or order of a court lawfully brought before it for review, and may remand the cause and direct the entry of such appropriate judgment, decree, or order, or require such further proceedings to be had as may be just under the circumstances. June 25, 1948, c. 646, 62 Stat. 963

Rule 52. Findings by the Court

(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings

are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41 (b).

Rule 65. (d) Form and Scope of Injunction or Restraining Order. Every order granting an injunction and every restraining order shall set forth the reasons for its issuance; shall be specific in terms; shall describe in reasonable detail, and not by reference to the complaint or other document, the act or acts sought to be restrained; and is binding only upon the parties to the action, their officers, agents, servants, employees, and attorneys, and upon those persons in active concert or participation with them who receive actual notice of the order by personal service or otherwise.

Appendix G, Copy of United States Patent No. 3,757,087 appears below on page a-63.

Appendix H, Consent Judgment of The District Court for the District of New Jersey dated and filed September 6, 1978

UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY
CIVIL ACTION NO. 78-647
VPB

INTERDYNAMICS, INC., and
SMITHS INDUSTRIES, LIMITED,

Plaintiffs,

-vs.-

FIRMA WOLF, AREND WOLF, and
TRANS TECH, INC.,

Defendants.

The plaintiffs Interdynamics, Inc., and Smiths Industries, Limited, and the defendant Trans Tech, Inc. having composed their differences and having consented to the entry of the following Judgment in this case, it is hereby

ORDERED, ADJUDGED and DECREED, as between the parties hereto that:

1. This Court has jurisdiction over the parties hereto and the subject matter of this action;

2. Barnard United States patent 3,757,087 for HEATING ELEMENTS, owned by plaintiff Smiths Industries, Limited and solely licensed to plaintiff Interdynamics, Inc., is both good and valid in law and is enforceable;

Appendix H. Consent Judgment of The District Court for the District of New Jersey dated and filed September 6, 1978

3. Defendant Trans Tech, Inc. has infringed Barnard United States patent 3,757,087 by using and selling rear window defrosters identified with the trademark "JUSTLIKE" and manufactured by defendant Firma Wolf under the direction and control of defendant Arend Wolf.

4. Defendant Trans Tech, Inc. and all those in privity with it are hereby enjoined from infringing any claim of Barnard United States patent 3,757,087; and

5. Each party shall bear its own costs.

Dated: Newark, New Jersey
Sept. 6, 1978

S/Vincent P. Biunno
United States District Judge

CONSENTED TO:
JERSEY CITY, NEW JERSEY
Dated: Brooklyn, New York
August 28, 1978

INTERDYNAMICS,INC.,

Dated: London, England
August 7, 1978

SMITHS INDUSTRIES,LIMITED,

Dated: New York, New York
12 July, 1978

TRANS TECH, INC.,

Acknowledgment by Parties Before Notary Public Omitted

Appendix I. Copy of Letter of McCauley, Fields, Fisher & Goldstein dated June 14, 1978 to Henry R. Lerner, Esq., and concurred to by Henry R. Lerner, attorney for Interdynamics, Inc. and Smiths Industries, Limited

LAW OFFICES OF
McAULAY, FIELDS, FISHER & GOLDSTEIN

June 14, 1978

L-1

Henry R. Lerner, Esq.
Levisohn, Niner & Lerner
535 Fifth Avenue
New York, New York 10017

Re: Interdynamics, Inc. et al
vs.
Firma Wolf et al

Dear Mr. Lerner:

I apologize for the delay in response to your May 26th letter but too many things have come about at once.

I have sent your proposed settlement to my client Trans Tech. As I indicated to you on the telephone I find the proposal satisfactory. However my client, in a desire to make sure that everything is clear to him as well as to us lawyers, would appreciate an explicit statement concerning his freedom to market rear window defrosters. Specifically I have explained to my client that the settlement agreement and consent judgment does not bar Trans Tech, Inc. from manufacturing rear window defrosters as long as they do not infringe United States Patent 3,757,087. My client, of course, understands that the agreement constitutes a concession by him that

Appendix I, Copy of Letter of McCauley, Fields, Fisher & Goldstein dated June 14, 1978 to Henry R. Lerner, Esq., and concurred to by Henry R. Lerner, attorney for Interdynamics, Inc. and Smiths Industries, Limited

the specifically identified rear window defrosters which are sold under the trademark "JUSTLIKE" and which were manufactured by the defendant Firma Wolf do infringe the patent.

If you concur with the above and would sign and return a copy of this letter to me, then we will proceed to an execution of the documents that you forwarded to me under cover of your May 26th letter.

Sincerely yours,

Lloyd McAulay
Attorney for Trans Tech, Inc.

I concur with the above

Henry R. Lerner
Attorney for Interdynamics, Inc. –

Appendix J., Copy of Transcript of Proceedings before Hon. Vincent J. Biunno on November 13, 1981

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY

INTERDYNAMICS, INC. and
SMITHS INDUSTRIES LIMITED,
Plaintiffs,
v.
FIRMA WOLF, AREND WOLF, AND
TRANS TECH, INC.,
Defendants.

TRANSCRIPT OF PROCEEDINGS

Newark, New Jersey
November 13, 1978

BEFORE:
THE HONORABLE VINCENT P. BIUNNO, U.S.D.J.

APPEARANCES:
MESSRS. FISH & NEAVE (NY)
BY: ALBERT E. FEY, ESQ.
and
MESSRS. LEVINSON, NINER & LERNER (NY)
BY: HENRY R. LERNER, ESQ.
Of Counsel
MESSRS. MC AULAY, FIELDS, FISHER & GOLDSTEIN (NY)
BY: LLOYD MC AULAY, ESQ.
Of Counsel

Appendix J., Copy of Transcript of Proceedings before Hon. Vincent J. Biunno on November 13, 1981

INDEX

EXHIBIT	DESCRIPTION	IDENT.	EVID.
C-2	Custom trim pinstripe tape	3	3
C-3	Pinstripe tape - white	3	3
C-4	Lafayette Radio sensing tape	3	3

THE COURT: All right. This is Interdynamics, Inc. versus Firma Wolf, et al, Civil 78-647 heard on November 9th.

Was there any court exhibit marked?

THE CLERK: One.

THE COURT: All right. Defendant's Exhibit 10 is a card mounted product called a custom trim multi-stripe kit, sounds familiar, not the particular brand but the type of product. These appear in any number of types of stores and on the weekend I happened to be in two stores for other purposes, one an auto and supply store and the other a radio electronic store, and in the auto store I saw two items that I thought ought to be marked as exhibits, if you will look at them.

First, it should be marked C-2 for identification at this point, which is a custom trim pinstripe tape, evidently, by the same manufacturer as D-10, which is metallic gold colored, and it seems to be about a quarter inch or three-sixteenths in width.

C-3 for identification is a product by the same company called pinstripe tape. This one happens to be white

and it's one-sixteenth, which is the width measured on the defendant's product. That will be C-3 for identification.

(C-2 and C-3 were marked for identification.)

C-4 for identification is a Lafayette Radio product called sensing tape for recorders with automatic stop and reverse controls and other sensing functions, and that's a strip rollup in what seems to be about three-sixteenths of an aluminum colored product. That will be C-4. Right?

THE CLERK That's correct.

(C-4 was marked for identification.)

THE COURT: Counsel, look at those and see if there's any objection to adding them to the collection of exhibits. There are many, many more on the shelves, as I'm sure you appreciate, but the gold one was picked because it is metallic. I haven't opened the package. I don't know whether it conducts electricity or not. The white one was picked because its dimensions are one-sixteenth and the Lafayette was picked because it is electrically conducted. It is used to operate contacts to work switches in tape recorders and I think I had made some reference to that during the testimony of one of the witnesses.

Mr. MC AULAY: I have no objections, Your Honor.

MR. FEY: Nor I.

THE COURT: All right, in evidence, then.

(C-2, C-3 and C-4 were received into evidence.)

Appendix J., Copy of Transcript of Proceedings before Hon. Vincent J. Biunno on November 13, 1981

THE COURT: Have you had time to review the file wrapper?

MR. FEY: We have, Your Honor, at least as far as the plaintiff is concerned.

MR. MC AULAY: Yes, I have.

THE COURT: It might even be added is there anything that you wish to add to the record by calling my attention to anything in it?

MR. MC AULAY: My difficulty is that I have not had access to anything except the Canadian patent and I feel that the discussion of the Burman patent, which appears, approximately, on page seventeen and thereabouts of a response to an office action which response is dated as having been received on February 9, 1973, raises questions that might be – that might bring up issues relating, if not to file wrapper estoppel, at least to issues of limitation of the scopes of the claims, but to do so I would have to analyze the Burman patents and, perhaps, a couple of other patents cited by the examiner, and I have not gotten those patents.

It appears to me I would like to make one point, that much of the discussion in the file wrapper emphasizes the two layers, the detachable covering layer on the release paper and the detachable support paper and indicates to me that having two separate layers is a meaningful part of the distinction over the prior art. However, I cannot make out a full case on that without spending a good deal more time without having the prior art.

THE COURT: Now, there's no question about service of the permanent injunction involved here, is there?

MR. MC AULAY: There is not.

THE COURT: It was consented to. What we have in this case is a suit on a patent for infringement in which the parties negotiated first in agreement, which is Exhibit H for the plaintiff, and pursuant to that agreement the final judgment disposing of the case or at least so it seems stating that the patent was valid and enforceable stating that the product then being marketed by Trans Tech infringed it and obtained a permanent injunction against infringement of the patent in suit as to Trans Tech.

The defendants Wolf had raised by motion an objection jurisdiction over them, not over the subject matter, which had been briefed and submitted and not yet decided when this new issue arose. The new issue arises out of the marketing by Trans Tech of a product, evidently, made by that company rather than by the Wolf Company, and the issue raised by the Order to Show Cause to hold Trans Tech in contempt is whether that current product does or does not violate any claim of the patent in suit.

The patent in suit seems to be a product patent. Since the original action was disposed of by consent judgment with no proceedings before the Court, the record does not have for the Court's benefit any of the usual materials that would have been available had there been a trial in terms of identifying precisely what the subject matter of the patent is, not only as to whether it is a product but, also, in respect to its scope.

Taking it as a product patent, the product consists of an assembly, the entire design of which is to make it possible to attach to the inside surface of the rear window of an automobile a pattern of electrical conductors with two terminals,

one of which is grounded and the other of which is connected to the automobile electrical supply through a dashboard switch. The object of the pattern of conductors is to apply heat by passing a current through the conductors; that heat being used either to remove mist, called fog, but it's actually mist, it's condensed, or snow or ice from the rear window.

As described in the patent and as marketed, the plaintiff's product comprises the entire window circuit, properly arrayed for attachment. In the present product as made, although, the patent may not limit it to that design, the pattern consists of what the Court sees as four sets of two parallel wires, the ends of which are alternately connected in series; so, there's one starting point and one ending point with current passing through two parallel conductors at each pass, so to speak, from left to right or right to left, as the case may be.

The patent does not purport to embrace the concept of having conductors applied to a rear window of an automobile as original equipment when it comes with the car, although, there seems to be no reason why the product made by plaintiff could not be used for that purpose if a manufacturer so desired. The testimony is that such applications have been made as recent equipment have either used a system in which resistance wires are embedded in the rear window glass in a similar pattern of horizontal runs or to one or another method applying to the inside surface of the rear window, probably, before manufacture assembly of the car itself of some kind of electrical conducting material which has a resistance designed for the twelve volt DC current voltage of automobiles currently manufactured as to provide the necessary wattage to serve the purpose.

One exhibit, a rear window from a Volkswagon, vintage unknown, seems to be of this type. Ordinary observation suggests that there are any number of means by which

such a pattern could be applied to a window intended to be used by manufacturers of automobiles. Certainly, tinplates could be used, silk screening, which is a form of tinplate, could be used; some sort of printing device could be used. I suppose there are others.

During the course of the hearing on November 9th, in response to questions from the Court, it appears that the patent in suit was not intended or designed to embrace all applications of the product where the general purpose is to supply heat to a surface to which the circuit can be attached. There are, of course, other such applications in rear windows of automobiles. One of the very common ones, a household appliance, is the heated tray for serving various articles of food or beverages, and in such applications there are, no doubt, could be different geometric designs; for example, with a concentrated coil circuit at one part to provide additional heat sufficient to keep liquids such as coffee warm, while providing less heat over the remainder of the tray for some articles of solid food; but although the mechanism and the product could be identical, except as to geometric design, it's the Court's understanding that the patent suit does not embrace that kind of application.

Also, it seems fundamental that since there are many, many ways of obtaining electrical conductors, and since all electrical conductors have some resistance, except, perhaps, at absolute zero, any person wishing to do so could undoubtedly design and hand make some kind of heating unit for his rear window. He might attach terminal strips at each end and, then, stretch some heating wires of appropriate thinness from one side to the other and thereby avoid the difficulty of the prior art in this field, which seems to have involved the use of a sheet of plastic containing the conductors which had a number of disadvantages; one of which was the accumulation

of dirt and the other was the visibility; third of which was the relatively poor, by contrast, ability to convey heat by conduction contact.

Certainly, the patent does not go so far in its scope as to cover electrical conductors having resistance characteristics which could be applied for the purpose of providing heat to a rear window, nor is it claimed to go that far. Consequently, products with pressure sensitive adhesives, such as are illustrated by Exhibit D-10 and by C-2, C-3 and C-4, assuming that they have electrical conductivity and electrical resistance, could be used by anyone who wished to construct such an apparatus on the rear window of his car or on any other surface which he wished to heat. I suppose the same kind of thing could be used on fish tanks controlled by thermostat to keep the water at a suitable temperature for, let us say, tropical fish; or, presumably, it could be used on the outside of fiberglass or other insulating material for tanks in which photographic solutions are contained and which very often must be held at rather precise temperatures, sometimes within plus or minus one half degree. So long as the required temperature is higher than the typical room temperature, a device of this sort, presumably, would have some use, again, controlled by the suitable thermostatic switch.

In principle, there's no reason why this kind of device could not be used with any voltage whatsoever, this merely being a function of calculating the resistance called for in the circuit for the given voltage in order to produce the wattage per square surface that is called for by the application.

Now, some of the products on the market, the type the Court has mentioned, have a so-called backing strip and others do not. It's the ordinary patching tape, I won't mention any brands, but transparent cellulose tape or mat surface

cellulose tape, consists of a strip of tape to which there has been applied a pressure sensitive adhesive and it's sold in rolls. There isn't any backing sheet to pull off. Simply strip the roll in the desired length and cut it off or tear it off. The same is true of modern kinds of plastic electrician's tape. That is usually some kind of insulating - that is, electrical insulating tape ordinarily black with a pressure sensitive coating on one side that's sold in rolls. Simply unroll as much as you need and either cut it or tear it or break it off in one fashion or another.

What is involved here is slightly different than those, although something that's simple as a strip of metal with pressure sensitive adhesive typified by the sensing tape of Lafayette Radio. Whatever that can serve, if someone wished to do so, to construct a grid of electrical conductors with resistance on his own rear window. In this sense, that sort of material is equivalent to buying lumber to build something which may be a bookcase or chair or house. It is a stock item with many, many applications. I suppose if someone were to publish a small pamphlet with a list of different ways for those who are handy to defrost their rear windows, now, they could include in that booklet the suggestion that the person who searched the market may even provide names and addresses and prices for a twelve volt blower that could be plugged into the cigarette lighter with a small heating element, perhaps, if it doesn't come that way, with instructions on how to add a heating element; or he might give, as a second method, a description which was mentioned during the hearing by the Court in finding a suitable electrical conductor, either glass or metal or ceramic, as is now available, perhaps, an inch wide, installing that with suction cups to the bottom edge of the rear window, connect it to the battery so that the heat is generated through a chimney effect, since most rear windows today are tilted inward, generate hot air along the bottom which would then flow upward along the inside surface of the glass; or he might show

ways to form a grid of conductors and suggest that materials, like the sensing tape or anything else that may be available on the market could be used for this purpose. The Court doubts that a booklet of that type would constitute an infringement of the patent. The Court doubts that a purchaser of the patent who bought some conducting resistance material and applied it to his rear window would be violating the infringement patent; and so, the question here is whether the defendant, Trans Tech's current product is sufficiently different from both the claims of the patent and the Wolf product as to conclude saying that it is merely a colorable difference. Somewhere between the Wolf product and the present product of Trans Tech and the examples given in regard to the assembly of such an apparatus by unit, there is a line beyond which the scope of the patent does not reach. So far as the hearing is concerned, the Court does not have before it the question whether the Wolf product is within or without the scope of the patent because the parties have agreed that it is. They're agreeing it is infringing. Nor does the Court have before it the question of the validity of the patent because these parties have agreed that it is valid. Other parties, whether in this case or elsewhere, are not bound by that agreement; but the parties to this hearing are bound.

One of the questions raised is whether this matter could be heard on Order to Show Cause for contempt. As indicated in the Mc Culloch Tool v. Well Surveys 395 Federal Second, 230, 10th Circuit, 1968, it appears that it can. That case, incidentally, has been checked for later citation and it does not appear to have been cited in other circuits, nor does it appear to have been cited in the Third Circuit. The problem, however, is not whether it can be but whether it should be. As the 10th Circuit pointed out in Mc Culloch, the question of procedure is one of deciding between two contending considerations, thus, as the Court points out at 233, allowing

the holder of the patent to proceed in summary contempt in all cases would unnecessarily deter parties to the case from marketing new devices that are, in fact, outside the scope of the patent. That's one consideration.

The other one is that to require the holder of the patent in every case to file a new infringement suit would diminish the significance of the patent as well as the outstanding permanent injunction in the case. Locating this dividing line seemed not to have been formulated with any high degree of precision, and to the extent that there are cases on the point it appears to be measured by whether the new device is or is not merely colorably different from the enjoined device or from the patent claims.

Now, a term like colorably different is a variable. It all depends on where the infringing product stood on the scale, let us say, of variables in relation to the patent and in relation to whatever divides the patent from those things which are outside of the scope. There are boundaries to every patent. If the original infringing device is, essentially, identical or, let us say, near the center of the area encompassed by that boundary, then, a new device would need to be quite different, presumably, to fall outside the boundary.

On the other hand, where the infringing device itself, although infringing, is near the boundary line of the scope, then, a much smaller difference may suffice to take the new product outside the boundary of the scope. How this is measured, of course, is another matter.

In the present case, in the light of all testimony, the Court does not feel that it can comfortably say that the new device infringes the claims of the patent or that it is merely colorably different from the patent claims or from the enjoined

device. A finding of that kind is not a determination that the new device does not infringe. It is merely a determination that the Court is unable to say that the comforting is needed for the purpose that the marketing of the new device is, upon the basis of the record, a contempt of court.

I should say, of course, that the current product lacks what I have referred to as the backing sheet. Instead of that, the structure of the product is like that in Exhibit D-10, which the Court has taken a sample of and applied it according to the instructions and finds that the red stripes of whatever material they may be do adhere to, essentially, nonabsorbing surfaces such as painted surfaces, glass surfaces, plastic surfaces and the like; and that the plastic band which holds these stripes in their position can easily be removed from them and from the surface which the stripes are applied without difficulty.

D-10, as the Court says, is like the FirmaWolf product because it does have a backing sheet which must be removed before the end product, namely, the stripes, can be applied to some surface. The Court took, also, a segment of Exhibit D-10 and removed the backing strip and found that what was left could be rolled by itself and, again, unrolled as one would unroll an electrical tape or any other material which has pressure sensitive adhesive without a backing tape; the only element of convenience being that the end at the outside circumference should preferably be folded over by a quarter of inch or so so that it itself will not adhere the next turn which would make it somewhat difficult to remove it.

Also, there is some risk in this form of rolling that in attempting to unroll it, one might detach the bands which are intended to be carried by the plastic from the plastic itself, thus, resulting in transfer to the next coil of plastic on the roll instead of to the final application for which it is intended. However, if materials like that in the Lafayette Radio sample were

to be applied, it seems quite clear that that would accomplish the purpose and that has no backing sheet to be removed, nor does it have any transfer mechanism.

Presumably, a strip of aluminum without a supporting plastic sheet could be marketed and used along with instructions for assembling or conducting a heating element for rear window, and that certainly would not infringe any claim of patent the Court can make out. It should be noted, too, that since there was no trial, the Court feels somewhat uncomfortable that the prospect of judging a defendant in contempt for violating the provision of a permanent injunction was correct, that it should not infringe any claim of the patent without the benefit of the background and defining a trial of the issue of validity of infringement would have had, particularly, in light of the specialized language which is typical of patent claims. The Court doubts that it should be necessary for the plaintiff to file a whole new complaint on the product, if it chooses to challenge defendants' activities. The cases seem to authorize what might be called a supplementary adjudication in a situation of this type, one of the decisions being Minerals Separation Ltd. against Miami Copper Company, 269 Federal, 265 Court of Appeals, Third Circuit, 1920. Of course, that case and, maybe, others like it preside the current rules of civil procedure and it may be that there are even simpler methods. In any event, what would seem to be required is a document sufficient to put the defendant on notice that plaintiff claims that the new product infringed the patent. Of course, if it does, it, also, would be in contempt that that would follow the first determination.

In this case, the moving papers and the Order to Show Cause seem to the Court to be sufficient for that purpose. The defendants' responding papers would seem to be adequate to serve the purpose of an answer. Considerable testimony on

the subject has been taken, although, the testimony was taken on the return of an Order to Show Cause. There's no reason why the Order to Show Cause cannot be treated as though it had been an Order to Show Cause why further injunctive relief should not be granted based on the claim that the new product, like the first one, also, infringes that.

Treating that application as an application for permanent injunction on which the Court concludes that it is not sufficiently confident to be able to warrant the grant of permanent injunction still remains possible under Rule 65A2 to direct that the hearing on the merits be advanced and consolidated with the initial hearing, at least in the sense that all evidence so far taken would be considered at the trial on the merits for, let us say, the remainder of the trial on the merits.

The Court can, conceivably, set some fairly compact time period for any further discovery and a later date for completion of trial on the question of infringement; but in the meantime, at this stage of the case, it does not feel justified in entering an order of judging the defendant in contempt; and do you gentlemen have any views on how we should proceed from here on if given those suggestions?

MR. FEY: Your Honor, I would ask that the discovery period commence immediately and be cut off as soon as Your Honor would have it cut off, and that we have that trial on the validity issue just as soon as possible. I feel that my client is being irreparably damaged by these defendants being permitted to show their wares at this Chicago show. I recognize that Your Honor has ruled against us, but I think that the only–

THE COURT: For the limited purpose of this kind of proceeding, I don't feel the confidence that I think I would need for a contempt order.

Appendix J., Copy of Transcript of Proceedings before Hon. Vincent J. Biunno on November 13, 1981

MR. FEY: I believe, Your Honor, that in the circumstances in which Your Honor's mind is what it is, that the way to minimize the irreparable injury which my client is suffering and will continue to suffer is to have that infringement hearing at the earliest possible time, and I respectfully urge the Court to set it now.

THE COURT: So far as setting a shorter than usual time for discovery, I'll need some indications as to what discovery is needed. Now, our normal period is 90 days after the issues are closed. Take that as today. You know what the issues are, I think, adequately, and does this new product infringe the patent? If it does, then, of course, also, violates the permanent injunction which was agreed to?

Do you have any idea of how much discovery will be called for? You wouldn't need, I take it, speaking now to counsel for Trans Tech, you wouldn't need to get any discovery from the plaintiff, would you, particularly? We know what they do. So far as we need for this case, they produce a product within the scope of the patent which is a complete assembly packaged in a fashion to permit its application to its intended use without having to put pieces together.

MR. MC AULAY: If I needed any discovery, it would probably be one day's deposition would probably be adequate.

THE COURT: Well, I wasn't limiting it to depositions. One effective and efficient form of discovery is all too often not used much, is the request for admissions. You may wish to make some kind of literature search.

MR. MC AULAY: Yes, we will.

THE COURT: And to submit your copies of what

you find in the literature to the plaintiff and request that they admit this is a true copy of an article that appeared in 1932 Popular Mechanics, whatever. I don't know what you'll find. Technical publications are all available to deal with this kind of question, if they're pertinent. Whether they're indexed or not, I don't know, but certainly, Popular Mechanics, Popular Science, publications of that kind are still in publication and their publishing offices may well have indexes. I don't know. Engineering texts may have articles.

MR. MC AULAY: Till I look into it, I really don't know what kind of time would be involved. I can certainly concur that there's some expediting handling of this, I have no objection. I would only point out that it's my understanding that this season is, essentially, over as far as at least my client's concerned, as far as any new customers are concerned and as far as most of his product sales are concerned.

THE COURT: Well, you mean in this part of the country?

MR. MC AULAY: Well, as far as he's concerned I don't – he sells north of here, too, but the season being essentially over in that his customers, being the stores that sell these things, have, basically, put in their orders, basically, have their deliveries.

THE COURT: When does the season begin?

MR. MC AULAY: I don't know. I think it's sometime in the summer or something as a manufacturer season, not as a store, the season for the store, but for the manufacturer. I don't know. I have to find out.

THE COURT: Still, if we're talking in those terms, you wouldn't expedite this at all.

MR. MC AULAY: I don't know what the —

THE COURT: Ninety days would take you to, say, the middle of February.

MR. MC AULAY: Yes.

THE COURT: And that certainly is not the summertime.

MR. FEY: Your Honor, if I might be heard, briefly.

THE COURT: I think it should be expedited because the case is over and we are now reopening, in effect, a closed case, and I think the suggested procedure strikes a balance between the summary proceeding on the one hand and requiring plaintiff to file a fresh complaint, start over again on the other hand, that hardly makes sense because we do have a trial.

MR. MC AULAY: Of course.

THE COURT: All that would do would be run up expenses for the client.

MR. MC AULAY: No point in that.

THE COURT: Clutter up the Court with another document.

MR. MC AULAY: I concur completely.

THE COURT: So, I'm going to set a target date, cutoff of December 22, and I'll set a trial date right after the lst of the year. I don't know what date it will be because I have to look at my criminal calendar, but this would not

be a long hearing in addition to what we have, I'm sure to the extent documentation and to the extent authenticity is not in dispute, and that much of the case is already submitted; but in any event, even if I have a full calendar it is possible to take a day here or there, either in between criminal cases or sometimes when something comes up during a criminal case where we can't sit, sometimes we have a juror who is ill, party who is ill, attorney who is ill, a few days and we can put in a civil case that's ready on short notice. In other words, if you complete your discovery by December 22, and be prepared to go to trial on two or three days' notice sometime after the lst of the year, we'd be able to fit you in.

MR. MC AULAY: I feel fairly sure I can complete discovery by December 22.

THE COURT: If you find you haven't finished, I can't forecast any better than you can, if you want more time you'll have to show me you've been diligent. I think that's a reasonable requirement.

MR. MC AULAY: Yes, sir.

THE COURT: Will you submit an order on today's disposition?

MR. MC AULAY: I'm sorry?

THE COURT: Will you submit an order on today's disposition?

MR. MC AULAY: All right. I will do so.

THE COURT: Thank you, gentlemen.

MR. MC AULAY: Thank you.

MR. FEY: Thank you, Your Honor.

THE COURT: Now, I will try this week to rule on the open motion.

MR. FEY: We appreciate that, Your Honor.

THE COURT: And I would say that the testimony that was adduced may have some bearing on the disposition of that motion.

MR. MC AULAY: I'm sorry, Your Honor?

THE COURT: I don't say that it will, but it may I learned some facts during hearing that may have some bearing on the disposition of the open motion as to what the activities have been up to this point.

These two are exhibits, too.

MR. MC AULAY: Pardon me, Your Honor. When you further —

THE COURT: Go ahead.

MR. MC AULAY: I misunderstood. The open motion is the motion on Wolf?

THE COURT: Right, nobody is here to speak for Wolf.

MR. MC AULAY: That's correct.

THE COURT: Merely comment to those who are here, the records of the hearing may be of some assistance.

Thank you. I think that's it for today.

MR. FEY: Thank you, Your Honor.

MR. MC AULAY: Thank you, Your Honor.

(Whereupon the hearing was adjourned at 3:45 p.m.)

—o00o—

I, JACQUELINE AUGUSTO, a Certified Shorthand Reporter and Notary Public of the State of New Jersey, certify the foregoing to be a true and accurate transcript of my stenographic notes.

JACQUELINE AUGUSTO, C.S.R.

Dated: November 18, 1978

Appendix K, Memorandum Decision of the District Court for the District of New Jersey dated Sept. 14, 1981

UNITED STATES DISTRICT COURT
Room 411, U.S. Post Office Building
NEWARK, NEW JERSEY 07102
FTS No. (8) 341-2517

VINCENT P. BIUNNO **(201) 645-2517**
JUDGE **(201) 642-2451**

MEMORANDUM

Re: Interdynamics v. Firma Wolf,
Civ. 78-647

The Court of Appeals reversed this court's ruling that defendant Trans Tech had not been guilty of a contempt of court when it marketed a new version of its product. It remanded the case so that a judgment of contempt might be entered against Trans Tech, and for such further proceedings as might be necessary, see 653 F.2d 93 (CA 3, 1981). The judgment in lieu of mandate was filed by the clerk here on August 6, 1981.

Interdynamics meanwhile sent the court a copy of a proposed order adjudicating Trans Tech in contempt and calling for an accounting and damages. Trans Tech responded that it was preparing its own proposed order, and later that negotiations were in process.

None of these steps were of record, and the court accordingly filed a memorandum noting the steps taken to that point in an informal fashion.

Trans Tech then filed application for an order to show cause why still another version of its competing product

should not be adjudged as not in contempt. The order issued August 27, 1981 and the matter was heard September 8, 1981.

A brief review is in order. The patent in suit, Barnard U.S. Patent No. 3,757,087 ('087) is on an intermediate device whose purpose it is to apply to a surface a fixed array of strips of a metallic conductor so that the surface may be heated by the passing of an electric current through the resistance presented by the conductor. Although not so limited by the claims, the intermediate is intended to be used to apply the conductor array to the rear window of an automobile for defrosting or defogging. Since such rear window defrosters are often provided by automobile manufacturers as original equipment, the patented intermediate device is intended for the so-called "after market", i.e., for cars not so provided with original equipment defrosters. So far as the patent and its claims are concerned, however, it would be infringed by a car manufacturer if such an intermediate device were used to install original equipment.

When suit for infringement was filed, Trans Tech was marketing a competing product. The Interdynamics product was designed as a means for packaging and applying the entire array to the rear window, in the form of a rectangular "coil" of continuous aluminum strips spaced at fixed parallel distances horizontally, with turns at the ends to provide a continuous circuit. The array terminated in two ends at a bottom corner, where contacts were provided to connect the array to wires leading to a switch and the electrical supply.

The final array of conductor/resistance on the rear window is not what was patented. The subject of the patent was the intermediate which was designed for packaging and application. The array itself was mounted on a plastic sheet and attached to it by a "weak" pressure sensitive adhesive. The opposite surface of the array was coated with a "strong"

pressure sensitive adhesive which was also thermosetting, i.e., it would harden when heated. That surface, in turn, was covered with another plastic sheet for protection. This formed a "sandwich", with the array between the two plastic sheets. The covering sheet would be removed, the array (on the mounting sheet) would be pressed against the rear window surface, and then the mounting sheet would be removed, leaving the array on the glass.

The first competing product, made for Trans Tech by Wolf in Germany, used the same sandwich system but did not provide a complete array. Instead, the intermediate was a number of strips, each carrying two narrow conductors, parallel spaced. The measurements were selected so that after removing the cover sheets, a group of units could be pressed on to the rear window so that the narrow conductors were lined up with uniform parallel spacing, after which all the backing sheets were removed. This provided a series of conductors but not a continuous electrical circuit. To achieve that, two vertical end strips were attached, one at each end.

There was no trial on the original complaint. Instead, after some extensions of time to answer and a motion by the Wolf company based on lack of in personam jurisdiction, the court was presented with a consent judgment as to Trans Tech, which was signed September 6, 1978. There were 5 paragraphs.

The first conceded jurisdiction over the parties and subject-matter. The second conceded the validity of the Barnard '078 (sic) ['087] patent, and that it was licensed solely to Interdynamics. The third conceded that Trans Tech had infringed the patent by using and selling the Wolf product. The fourth paragraph provided:

"4. Defendant Trans Tech, Inc., and all those

in privity with it are hereby enjoined from Infringing any claim of Barnard United States patent 3,757,087".

The fifth and last paragraph provided that each party was to bear its own costs.

As explained at the later contempt hearing, this disposition was the result of a strategy and evaluation by Trans Tech and its patent counsel that the case was not worth the expense of litigation since a non-infringing product could be marketed by "working around" the patent, and so the consent judgment was negotiated to close out the case at nominal cost, but with the intent to resume competition with a different and non-infringing product. This course was evidently selected without disclosing the new product to Interdynamics and without securing a ruling in advance on the question whether the new product would violate the permanent injunction.

The result was that when the new product was marketed, Interdynamics moved to hold Trans Tech in contempt. The law on the subject being unclear, the court undertook a plenary hearing to decide whether the new product infringed any claim of the Barnard '087 patent, and concluded that it did not.

On appeal, the panel reversed on the ground that the court had tested the new product against the claims of Barnard patent '087, when the correct test, it ruled, was whether the new product was only colorably different from the infringing Wolf product.

The difference between the Wolf product and the new Trans Tech product was that the sandwich format was eliminated. The parallel conductors were now placed on a single

mounting strip and rolled up. The difference is like the difference between a jelly sandwich and a jelly roll.

In considering the contempt charge, the trial court judged the new product against the Barnard '087 claims for several reasons. One was that what the judgment enjoined was "infringing any claim" of the '087 patent. Another was the requirement of Rule 65(d), F.R.Civ.P., that every injunction "shall be specific in its terms", and shall describe in reasonable detail *** the act or acts sought to be restrained." Since the injunction was expressly against "infringing" the '087 patent claims, the trial court used that reference for the test. Another reason was that no patent gives protection against matter in the public domain, a basic principle calling for an evaluation of the scope of the patent in the light of prior art to determine what the patent disclosed that was "new".

The Court of Appeals ruling, however, addressing the legal question for the first time, concluded that the new product is to be compared, not with the patent claims but with the infringing product, and if it were only colorably different in light of the doctrine of equivalents, a contempt will be shown without considering whether the new product infringes any claim.

The trial court has considerable difficulty with this approach largely because the doctrine of equivalents is much more difficult and abstract in application than traditional tests of infringement in the light of prior art. It also has difficulty with the concept as applied to this case because the consent judgment enjoined "infringing" any claim of the '087 patent.

Difficult or not, the decision of the Court of Appeals is binding here and must be applied even though it was made

clear in footnote 5 that the court did not decide whether the new product did or did not infringe any claim of the '087 patent.

Trans Tech's next new product, for which it asks a ruling, consists of two rolls of conductor coated on one side with pressure sensitive adhesive, the two rolls being mounted on a mandrel to be set in a dispenser that will enable the user to lay out two parallel strips of conductor on the rear window surface. This system eliminated not only the protective sheet, but the mounting sheet as well. The mandrel and dispenser are thus relied on to enable the user to lay down spaced, parallel strips of conductor just as the Wolf product did, and just as the new Trans Tech product did.

Applying the rule laid down by the Court of Appeals, the court compares the proposed product with the Wolf product and applies the doctrine of equivalents. As stated:

> "[I]f two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though different in name, form or shape". See 653 F.2d at 99.

The Wolf product did not do what the Interdynamics patent does. It lays down only 2 parallel, spaced strips at a time, and not the complete array. The parties agreed that this was an infringement, and the consent judgment so provides.

Trans Tech's next product, which eliminated the cover sheet, also laid down only 2 parallel, spaced strips at a time, as did the Wolf product, and the Court of Appeals ruled that by applying the doctrine of equivalents, it was not more than colorably different than the Wolf product, and so its sale and use was a contempt of the permanent injunction, without regard to whether it infringed any claim of the '087 patent.

Appendix K, Memorandum Decision of the District Court for the District of New Jersey dated Sept. 14, 1981

Applying that test, which is binding here, the proposed new product is no more than colorably different in comparison with the Wolf product. The use of two rolls of adhesive coated conducter, placed on a mandrel for mounting in a dispenser, will do the same work in substantially the same way to accomplish the identical same result, i.e., to lay down a parallel pair of conductors at a predetermined spacing, on the rear window, to build a rectangular array to serve as a heating element.

The court accordingly finds that the proposed new product, if marketed, would be a contempt in violation of the injunction.

Interdynamics claimed that the Trans Tech application should be denied because a ruling would amount to rendering an advisory opinion. The court disagrees. A party under restraint of a permanent injunction takes a needless risk in adopting a course of action which it believes (no matter how sincerely) will not contravene the judgment. The prudent course, when there is disagreement on the question as there is here, is to apply for a construction of the judgment. See, for example, *New Jersey v. New York*, 296 U.S. 259 (1935); *State ex rel. Jarboe v. Holt*, 444 S.W. 2d 857 (Mo. 1969) (en banc). Other instructive decisions and analyses are found in *National Ben Franklin etc. v. Camden Trust*, 21 N.J. 16 (1956) and *Lucky Calendar v. Cohen*, 19 N.J. 395 (1955) and 20 N.J. 160 (1955).

At the hearing of September 8, 1981, the court allowed Interdynamics to file a motion to settle the form of order on the contempt phase. Further disposition is reserved pending the submission of fact materials. Interdynamics is to send the court in chambers and under seal (a) an approximation of the attorneys fees incurred in connection with the contempt proceeding, and (b) the net profit realized by Inter-

dynamics on a per unit basis, or on a per case basis (indicating the number of units per case) during the period when Trans Tech's new product (to replace the Wolf product) was on the market. Trans Tech is similarly to submit to the court in chambers and under seal (a) the number of Trans Tech units sold after the judgment of September 6, 1978; (b) the net profit per unit realized by Trans Tech on those sales, and (c) the first and last dates when such sales were made.

After receiving that initial information, the court will instruct the parties further as to the next steps to be taken.

In the meanwhile, an order is to be submitted adjudicating Trans Tech in contempt, adjudicating that the proposed product if made and marketed would be a contempt, and reserving the matters of damages and attorneys fees.

September 14, 1981

s/ Vincent P. Biunno, USDJ

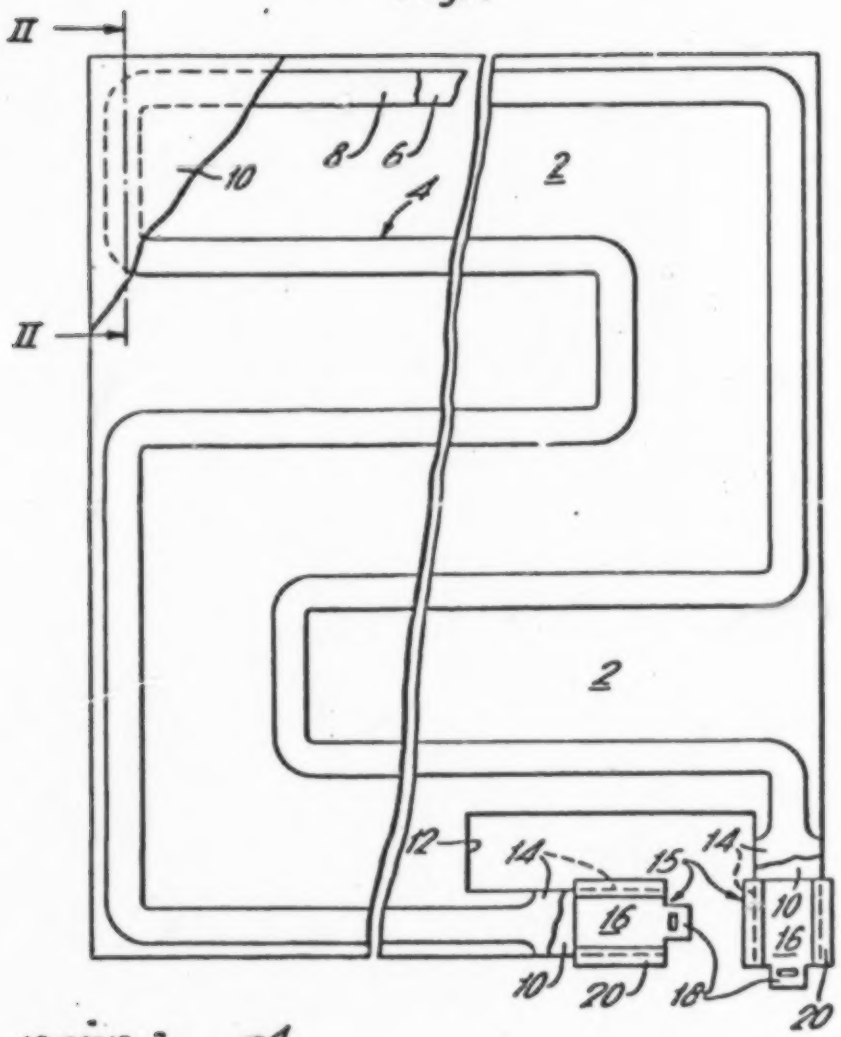
Original to Clerk
xc:Pitney, Hardin & Kipp, Esqs.
Kirsten, Friedman & Cherin, Esqs.

Appendix G, Copy of United States
Patent #3,757,087, patented
September 6, 1978

PATENTED SEP 4 1973

3,757,087

Fig. 1



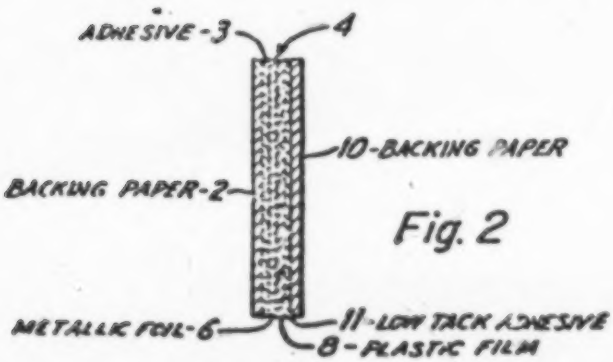


Fig. 2

Dominic Paul Edmund Barnard
Inventor

Attorney

Appendix G

United States Patent [19]

Bernard

[11] **3,757,087**

[45] **Sept. 4, 1973**

[54] **HEATING ELEMENTS**

[75] Inventor: **Dominic Paul Edmund Bernard, Witney, England**

[73] Assignee: **Smiths Industries, Limited, London, England**

[22] Filed: **Mar. 8, 1971**

[21] Appl. No.: **121,819**

[30] **Foreign Application Priority Data**

Sept. 11, 1970 Great Britain 43,477/70

[52] U.S. Cl. ..... 219/549, 52/171, 161/406, 174/117 A, 249/203, 219/526, 219/543, 338/210

[51] Int. Cl. H05b 3/36, B32b 7/06

[58] Field of Search ..... 219/201, 203, 213, 219/219, 345, 464, 467, 522, 526, 528, 535, 536, 538, 541, 543, 544, 546–549; 174/117 FF, 117 A, 84 C; 338/210–212, 283, 285, 292, 306, 311, 313, 314, 327, 331; 52/171; 161/406, 167

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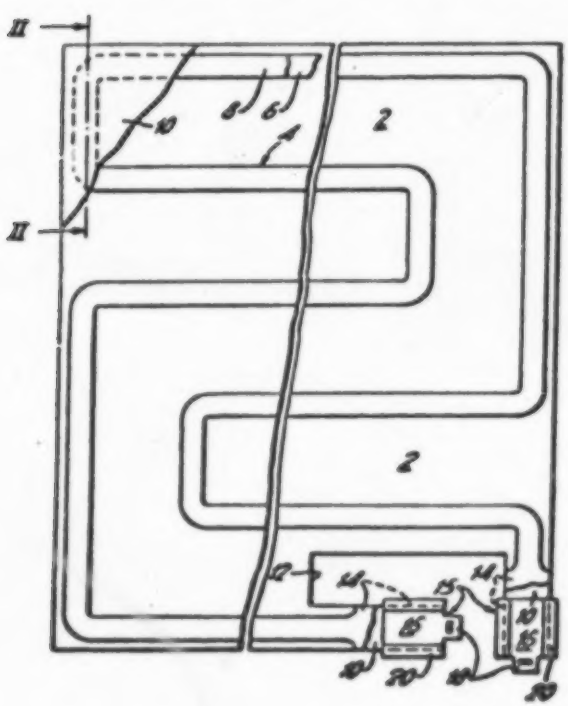
Primary Examiner—A. Bartis

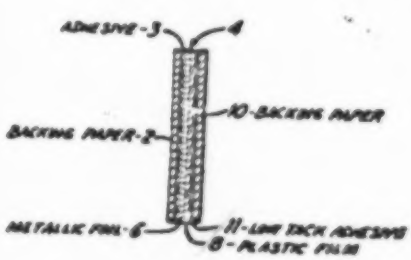
Attorney—William D. Hall, Elliott I. Pollock, Fred C. Philpitt, George Vande Sande, Charles F. Steininger and Robert R. Priddy

[57] **ABSTRACT**

Heater assembly that may be used for heating a surface such as the glass rear windscreen (or window) of a motor vehicle comprises a heater element having a continuous metal strip of sinuous form. The element is sandwiched between two paper backing sheets which are adhesively secured to opposed surfaces of the metal strip. A first backing sheet is for removal prior to the mounting of the element on an automobile rear windscreen, and the other backing sheet is to be removed after the element has been so mounted. The first backing sheet is coated with a silicone or wax to facilitate its ready removal from the element. The surface of the element covered by the other backing paper is provided with a layer of electrically insulating material.

12 Claims, 2 Drawing Figures





HEATING ELEMENTS

BACKGROUND OF THE INVENTION

This invention relates to heating elements and it is an object of this invention to provide a heating element that may be used for heating a surface such as the glass rear windscreen (or window) of a vehicle.

Heretofore to achieve this object it has been proposed that the heating elements be either embedded in the glass composition, an expensive arrangement, or be incorporated with a plastics material panel, the whole panel being affixed to the interior surface of the glass rear windscreen, an unsightly and rear-view restricting arrangement.

SUMMARY OF THE INVENTION

The disadvantages of the aforementioned prior art arrangements are minimized or largely overcome by the present invention, which, according to one aspect thereof, provides a heating element comprising a long, narrow strip of thin electrically resistive material having on one surface thereof a layer of adhesive, and having at the ends thereof an electric terminal. It will be appreciated that by means of the adhesive layer the heating element can be itself affixed directly to the interior surface of the glass windscreen so that an effective and aesthetically pleasing rear windscreen heater can be inexpensively installed.

Preferably the surface of the electrically resistive material opposite the adhesive is provided with a layer of electrically insulating material. The electrically resistive material is preferably a metal (e.g., aluminum) or metal alloy; the electrically insulating material is preferably enamel or plastics material (e.g., a polyester resin such as that sold in the United Kingdom under the Trade Mark "MELINEX"); and the adhesive is preferably thermo-setting.

The adhesive may be in surface contact with a readily removable, preferably fairly thick, backing layer which is conveniently constituted by a sheet of siliconized paper. Preferably the strip of electrically resistive material follows a path of sinuous form e.g., the outline of a thick "S."

The layer of electrically insulating material may be in surface contact with a wax compound whose melting temperature is of the order of the setting temperature of the adhesive, the wax compound conveniently being in surface contact with a rigid member, e.g., cardboard. Alternatively and preferably the layer of electrically insulating material is in surface contact with a low tack adhesive coating on one surface of a transfer layer which is conveniently constituted by another sheet of paper or cardboard.

The electric terminals may comprise width-wise enlargements of the ends of the strip. Preferably the enlarged ends are each sandwiched between two metal members, one of which is held captive by the upwardly and inwardly turned side edges of the other. Furthermore, one or the other of said two metal members may have sharp projections to dig into the enlarged end of the strip with which it is associated. One or other of said two metal members may be bowed convexly with respect to the strip and to the other or one of said two metal members so that the associated enlarged end is tightly compressed between the two metal members.

Preferably one or other of said two metal members is provided with a projecting blade, conveniently at an angle thereto, to mate with a female connector at one end of an electric wire. The metal member on the same side of the strip as said layer of adhesive may be in adhesion with one surface of a pad whose opposite surface has a pressure adhesive or contact adhesive thereon by means of which the terminal can be affixed to the interior surface of the windscreen.

According to another aspect of this invention there is provided a heating element, according to said one aspect of this invention, sandwiched between two supporting sheets. The sheets, conveniently of generally rectangular shape, may be of paper or cardboard.

Preferably the long, narrow strip of thin electrically resistive material is the residue of a die-stamping operation upon a sheet of such material adhesively mounted upon one of said supporting sheets, which one sheet constitutes a backing layer, prior to the application of the other of said supporting sheets.

BRIEF DESCRIPTION OF THE DRAWINGS

Three embodiments of this invention will now be described, by way of example with reference to the accompanying drawings, in which:

FIG. 1 shows the third embodiment in partly broken away plan view; and

FIG. 2 is a fragmentary diagrammatic sectional view on the Line II—II of FIG. 1.

DESCRIPTION OF THE PREFERRED EMBODIMENTS

In a first exemplary embodiment of this invention, there is provided a long length of metal strip approximately 1.8 m (2 yards) long, 150 μm (0.006 in) thick, and 1.6 mm (a sixteenth of an inch) wide. Preferably this strip is integrally provided with enlarged ends, e.g., twice as wide, to constitute electrical terminals therefor. One side surface of the metal strip is coated with a pressure-sensitive Use of resin adhesive lhat cures at 69 effeciive demsting 70° centigrade. The other side surface of the metal strip is insulated by a clear plastics material coating or by an enamel coating. The metal is chosen to have a resistance over its total length within the approximate range of 1 to 2 ohms.

The exemplary heating element so formed as applied in one test to the inner surface of a vehicle rear glass windscreen by contacting the adhesive layer directly to the glass while disposing the strip in a sinuous pattern over the glass. On the application of the vehicle's battery voltage of some 12 volts across the heating element, its temperature rise was sufficient to cure the adhesive and provide a permanent bond to the glass. Subsequent use of the permanently fixed heating element provided effective demisting and defrosting of the rear glass windscreeen.

In a second exemplary embodiment of this invention, a rectangular sheet of aluminum foil having side lengths approximately 20 cm (8 in) and 46 cm (18 in) long, has one surface bonded to a film of "MELINEX," and its opposite surface coated with a thermo-setting adhesive having a setting or curing temperature of the order of 70° C. A sheet of siliconized brown paper is in surface contact with the adhesive to form a backing member or supporting layer for the laminate. The siliconizing provides the paper with a low-cohesion surface. The surface of the "MELINEX" film opposite to that which is bonded to the aluminum foil is coated with polymeric wax whose melting temperature is somewhat less than

70° C and the wax serves to bond the laminate to a sheet of cardboard which provides a rigid mounting and further supporting layer for the laminate.

The six layer composite laminated rectangular structure so formed may be stamped or cut into a desired pattern which preferably comprises a thin strip following a sinuous snake-like path. The straight long sides of this sinuous strip lie parallel to the 8 inch long sides of the rectangular structure. The sinuous strip so formed may provide a heating element for heating a surface such as the glass rear windscreen of a vehicle. To achieve this the siliconized brown paper backing is peeled away from the strip which is then pressed against the interior surface of the glass rear windscreen. When electric current is applied to the aluminum foil via terminals provided at its ends, the heat produced by the current (which may be of the order of 10 to 15 amps) raises the temperature of the adhesive to thereby initiate curing or setting of the adhesive and also raises the temperature of the polymeric wax causing it to melt. As the polymeric wax melts, the cardboard providing a rigid support for the laminate falls away to leave the aluminum foil in strip form bonded by one surface to the glass rear windscreen with its opposite surface electrically insulated by the "MELINEX" film in corresponding strip form. Subsequent electric current passage through the heater so formed provided effective demisting and defrosting of the rear glass windscreen.

In a third exemplary embodiment of this invention, illustrated in the accompanying drawings, there is provided a rectangular laminated sheet, approximately 47 cm (18.5 in) long by 21 cm (8.5 in) wide and approximately 38 μm (0.0015 in) thick, comprising a layer of aluminum foil bonded to a layer of plastics material film e.g., a polyester such as that sold in the United Kingdom under the Trade Mark "MELINEX." Preferably the metal foil layer and plastics film layer have similar thicknesses. The exposed surface of the aluminum foil layer is coated with a thermo-setting adhesive, and a fairly thick sheet of backing paper having similar rectangular dimensions is then applied to this adhesive-coated surface to provide a supporting layer and covering for the laminated sheet. The backing paper, which is pre-treated with a low cohesion material such as silicone or wax, has a polished or smooth surface which is therefore a low-cohesion surface and is readily separable from the aluminum foil/MELINEX film sheet.

The two bonded sheets of backing paper and aluminum/MELINEX are subjected to a die-stamping operation from the MELINEX side. The pattern die-stamped is one of long, narrow strip form such that the strip follows a sinuous path, for example the border outline of a thick "S" (see the accompanying drawing). The width of the strip is approximately 3,200 μm (an eighth of an inch) except for its ends which have a large width of approximately 1.4 cm (nine-sixteenths of an inch). The depth of cut of the die-stamping operation is sufficient to pass wholly through the aluminum/MELINEX sheet but not through the backing paper. Thus, as illustrated in the accompanying drawing, the sheet of backing paper 2 supports by means of the thermo-setting adhesive 3 only the long narrow strip 4 of aluminum 6 bonded to MELINEX 8 after the remaining residue (not shown) of the aluminum/MELINEX sheet has been peeled away from the backing paper 2. Another paper sheet 10 (only part of which is shown), having similar rectangular dimensions to sheet 2, is coated on one surface with a low tack adhesive 11 and this surface is applied to the sheet 2 supporting the aluminum/MELINEX strip 4. The thickness of paper sheet 10 is not very important, although the thicker it is the more rigid support it will give to the strip 4 during installation (see below).

The rectangular laminate of strip 4 adhesively sandwiched between sheets 2 and 10 is formed with an L-shaped cut-out adjacent one corner in the vicinity of the strip's enlarged width ends 14. To each of these ends an electric terminal connector 15 is affixed making electrical connection with the aluminum part 6 of the strip end 14. Each terminal connector 15 comprises a flat metal plate 16 formed with an integral blade 18, extending at an angle to the plane of plate 16, and a shallow channel-shaped metal member 20 formed with a convex base having a plurality of upstanding sharp projections. Each plate 16 is placed on sheet 10 above its associated strip end 14 and placed within the metal member 20 whose upstanding edges project past the side edges of both strip end 14 and plate 16. Plate 16 and member 20 are clamped so that the projections of the convex base of member 20 pass through the backing paper sheet 2 and on into the aluminum. The electrical connection thus made is maintained by turning in the upstanding edges of member 20 to thereby maintain the clamping pressure. If desired the plate 16 may be convex to the sheet 10 as an alternative or in addition to the base of member 20 being convex to the sheet 2, and/or may have the sharp projections. A pad having a contact adhesive or pressure adhesive on both major surfaces is affixed to the base of each member 20.

The heating element constituted by the aluminum part 6 of the strip 4 is installed in a vehicle in the following manner for use as a rear glass windscreen (or window) heater. The interior glass surface is first cleaned with methylated spirits and allowed to dry. The backing paper 2 is readily peeled away from the strip 4 (adhesively mounted on the sheet 10) starting at the corner remote from the terminal connectors 15, and at the terminal connectors the backing paper is torn, using the edge of these terminal connectors as cutters. The strip 4 supported by sheet 10 is placed to the screen so that the thermo-setting adhesive 3 of the strip and the low tack adhesive 11 of the sheet 10 contact the clean surface of the glass. The strip 4 and terminal connectors 15 are pressed firmly to the glass, a check for good adhesion being obtained by viewing from outside of the glass (i.e., outside of the vehicle) — the strip 4 being visible as the outline of a thick "S." The supporting sheet 10 is then stripped off starting at the corner furthest from the terminal connectors 15, and torn off at the terminal connectors in a similar manner to that used before with the backing paper 2. A short electrical lead or wire having a female tag connector at one end connects one blade 18 to a ground point on the car body and another, long, electrical lead or wire similarly connects the other blade 18, via an electric on/off switch mounted on the dashboard, to a battery voltage point that is only energized when the vehicle ignition is on. If desired, a warning light can be fitted by wiring between the aluminum element side of the switch and ground. Such a warning light can be incorporated in the apparatus sold by Smiths Industries Limited in the United Kingdom under the Trade Mark "WARNA-

LITE " Furthermore the electric on/off switch may be such as that described in United Kingdom Application No 43478/70.

The laminate comprising sheet 2 in the form of a polythene coated, silicone release, heavy Kraft paper, and the sheet of aluminum bonded to MELINEX, which sheets are attached to one another by a cross-linked, acrylic based, thermosetting adhesive 3, may be obtained from Coated Specialities Limited, of Chester Hall Lane, Basildon, Essex, England. The sheet 10 coated with a low tack adhesive 11 may be one of the Butterfly Brand of Samuel Jones & Company Limited, Letchworth Mill, Pixmore Avenue, Letchworth, Hertfordshire, England.

I claim:

1. A heater assembly comprising a deformable electrical heating element which is to be adhesively secured to a surface to be heated and which has a plurality of limbs planarly disposed in spaced array, the heating element array having a continuous strip of electrically resistive material, two ends, and first and second opposed surfaces; two terminals electrically connected to said two ends of the heating element array respectively; a detachable covering layer; a first adhesive coating on the first surface of said strip for detachably adhering said covering layer to said first surface of the heating element array, the said covering layer being detachable from the heating element array prior to the mounting of said array on said surface; a detachable supporting layer; and a second adhesive coating in direct contact with said second surface for detachably adhering said supporting layer to said second surface of the heating element array to provide a predetermined level of adhesion therebetween, the said supporting layer being the sole support for maintaining the spatial relationship between the limbs of said heating element array after said covering layer has been detached, and said supporting layer being detachable from the heating element array after its mounting on said surface; the surface of said covering layer facing said first surface of the heating element array being a low-cohesion surface cooperating with said first adhesive coating to provide a level of adhesion between said covering layer and the first adhesive coating which is substantially less than the said predetermined level of adhesion between the said supporting layer and the second surface of the heating element array to enable the said covering layer to be detached from said heating element array more readily than the said supporting layer, whereby said first adhesive coating is exposed thereby to permit the heating element array, while supported by said supporting layer, to be adhesively secured to said surface by said first adhesive coating.

2. The heater assembly of claim 1 wherein the said limbs of the heating element array extend parallel to one another, the spacing between said limbs being substantially greater than the width of each said limb.

3. The heater assembly of claim 1 wherein said heating element array includes a strip of electrically insulating material bonded in surface contact and covering only said continuous strip of electrically resistive material, said insulating strip forming said second surface of said heating element array.

4. The heater assembly of claim 1 wherein said heating element array follows a path of sinuous form

5. The heater assembly of claim 1 wherein said first adhesive coating comprises a thermo-setting adhesive.

6. The heater assembly of claim 1 wherein the low-cohesion surface of said covering layer is a polished surface.

7. The heater assembly of claim 1 wherein said low-cohesion surface of said covering layer comprises a low-cohesion coating on the surface of said covering layer facing said first surface of the heating element.

8. A heater assembly comprising an electrical heating element which is to be adhesively secured to a surface to be heated, said heating element comprising a continuous strip of electrically resistive metallic foil material having a plurality of spaced foil portions electrically connected to one another and arranged in a predetermined pattern, said heating element pattern having first and second opposed surfaces; electrical terminal means connected to said heating element pattern; a detachable covering layer; a first coating of bonding material on the first surface of said heating element pattern for detachably adhering the said covering layer to said first surface of the heating element pattern, the said covering layer being detachable from the heating element pattern prior to its mounting on said surface; a detachable supporting layer; a second coating of bonding material in direct contact with the second surface of said pattern for detachably adhering the supporting layer to said second surface of the heating element pattern, the said supporting layer comprising the sole support for maintaining the configuration of said heating element pattern after said covering layer has been detached, and said supporting layer being detachable from the heating element pattern after its mounting on said surface; the surface of said covering layer facing said first surface of the heating element pattern cooperating with said first coating of bonding material to provide a level of adhesion therebetween which is lower than the level of adhesion between said supporting layer and the second coating of bonding material.

9. The heater assembly of claim 8 wherein said heating element pattern includes a plurality of limbs disposed in spaced parallel relation to one another, the spacing between said limbs being greater than the width of each of said limbs.

10. The heater assembly of claim 8 including a strip of electrically insulating material bonded to said strip of electrically resistive foil material in a pattern which corresponds to said predetermined pattern to form said second surface of the heating element pattern.

11. The heater assembly of claim 9 wherein said electrical terminal means comprises a pair of spaced electrical terminals connected to spaced portions of said metallic foil material, each of said terminal means comprising two metallic members having one of said spaced portions of metallic foil material sandwiched therebetween, one of said metallic members having a pair of side edges which are turned inwardly to retain the other of said metallic members in place.

12. The heater assembly of claim 8 wherein at least one of said detachable layers is in the form of a strip which is essentially coextensive with said strip of electrically resistive metallic foil material.

* * * * *

Opposition

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No. 81-753

IN THE

SUPREME COURT OF THE UNITED STATES

October Term 1981

TRANS TECH, INC.,

Petitioner,

v.

INTERDYNAMICS, INC. and
SMITHS INDUSTRIES, LTD.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

RESPONDENTS' BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

The questions petitioner presents for review may be stated more accurately as follows:

1. In a patent case where a consent decree has been entered which (1) adjudges that the patent in suit is valid, (2) adjudges that the defendant's original product is an infringement of the patent, and (3) enjoins the defendant from infringing the patent, may the defendant subsequently be held in civil contempt of the consent decree for making and selling a modified product that is "merely colorably different" from the original product?

2. In a proceeding to determine whether a modified product is a civil contempt of a patent consent decree, what evidence should the court consider on the issue of whether the modified product is merely colorably different from the product which the consent decree adjudged to be an infringement?

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RESPONDENTS' BRIEF IN OPPOSITION

Nothing in this ordinary patent case warrants review by this Court. The Third Circuit Court of Appeals followed the unanimous authorities in other circuits when it decided the issue of civil contempt of the consent decree by determining whether the modified product ("the Trans Tech product") was "merely colorably different" from the product which the consent decree adjudged to be an infringement of the patent in suit ("the Wolf product").

In its petition, Trans Tech accepts the colorably-different test, but argues that in applying that test the Court of Appeals should have examined the patent, the patent filewapper, and the prior art. Trans Tech is wrong for two reasons. First, the Court of Appeals *did* examine those patent documents. Sec-

ond, even if the Court of Appeals had not examined those documents, its decision would still be in accord with the decisions of the other circuit courts that have applied the colorably-different test.

There are no special and important reasons for review by this Court on writ of certiorari. No decisions are in conflict. The Court of Appeals did not depart from the accepted and usual course of judicial proceedings. And there is no important question of federal law that should be settled by this Court.*

STATEMENT OF THE CASE

At a minimum, Trans Tech's statement of the case requires the following elaboration.**

1. Proceedings In The District Court

In March 1978, Interdynamics, Inc. and Smiths Industries, Ltd. (collectively "Interdynamics") filed a complaint in the District Court for the District of New Jersey against Firma Wolf, Arend Wolf, and Trans Tech, Inc., alleging infringement of Barnard U.S. patent 3,757,087. Arend Wolf is the president of Firma Wolf, which is a Dutch corporation. Trans Tech is a New Jersey corporation.

The Barnard patent [A. 63] discloses and claims an apparatus for applying heating elements to planar surfaces. The primary commercial use for the Barnard invention is in applying defrosters to the rear windows of automobiles. The preferred embodiment of the invention is a sandwich. The heating ele-

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* Pursuant to Rule 28.1 of this Court, respondents state that neither respondent has any parent companies, subsidiaries (other than wholly-owned subsidiaries), or affiliates.

** For the convenience of the Court, citations herein are made, whenever possible, to the petition for certiorari ["Pet."] and to the appendix ["A."] that is included in the petition.

ments are sandwiched between "detachable" supporting and covering layers. There are special adhesives between these layers and the heating elements. The adhesives permit the covering layer to be peeled off without separating the heating elements from the supporting layer, and permit the supporting layer to be peeled off after the heating elements have been pressed against the windshield. The result is that the heating elements alone are left on the windshield.

Before Barnard's invention, rear window defrosters were made by incorporating heating elements into plastic panels. These plastic paneled defrosters were undesirable because they hindered vision and grew unsightly with age. Since the introduction of defrosters made in accordance with Barnard's invention, the plastic panel models have completely disappeared from the market.

At the time the complaint was filed, Trans Tech was importing and selling a defroster made by Firma Wolf ("the Wolf product"). The Wolf product is a sandwich. Parallel heating elements are sandwiched between two sheets of material that act as supporting and covering layers. To apply the heating elements to the rear window of an automobile, the consumer removes the covering layer and presses the exposed heating elements (with supporting layer still attached) to the glass. The consumer then peels off the supporting layer and is left with the parallel heating elements alone on the rear window. By repeating this process, the consumer may create a grid of heating elements of whatever size he chooses. The last step is to connect the heating elements to the car's electrical system so that electricity will flow through the heating elements and defrost or defog the glass.

Soon after the complaint was filed, Trans Tech approached Interdynamics for the purpose of settling the lawsuit. To obtain the settlement, Trans Tech agreed to the entry of a consent

decree adjudicating the validity of the Barnard patent and its infringement by the Wolf product. On its part, Interdynamics agreed to waive its right to damages for past infringements. On September 6, 1978, District Judge Vincent P. Biunno entered a consent decree [A. 31] containing the following paragraphs:

> "2. Barnard United States patent 3,757,087 for HEATING ELEMENTS, owned by plaintiff Smiths Industries, Limited and solely licensed to plaintiff Interdynamics, Inc., is both good and valid in law and is enforceable;
>
> "3. Defendant Trans Tech, Inc. has infringed Barnard United States patent 3,757,087 by using and selling rear window defrosters indentified with the trademark 'JUSTLIKE' and manufactured by defendant Firma Wolf under the direction and control of defendant Arend Wolf;
>
> "4. Defendant Trans Tech, Inc. and all those in privity with it are hereby enjoined from infringing any claim of Barnard United States patent 3,757,087."

At the time the consent decree was entered, Trans Tech was clandestinely developing a defroster of its own design ("the Trans Tech product"). The Trans Tech product differs from the Wolf product in only one respect. Whereas in the Wolf product the heating elements are sandwiched between two separate sheets, in the Trans Tech product the heating elements lie atop a single sheet which is rolled up on itself. Judge Biunno has aptly described the difference between the products as the difference between a jelly sandwich and a jelly roll [A.59]. In the Trans Tech product (the jelly roll), the detachable covering layer and detachable supporting layer are not separate sheets; rather, they are combined into one sheet, with one side performing the covering function and the other side performing the supporting function. To install the Trans Tech product, the

consumer first unrolls the product to uncover the heating elements, then presses the heating elements to the glass, and finally removes the supporting layer.

Trans Tech began marketing its product soon after the consent decree was entered, and on November 2, 1978, Interdynamics obtained an order to show cause why Trans Tech should not be held in contempt of the consent decree. During the hearing on the order to show cause, Interdynamics argued that Trans Tech should be held in contempt because the Trans Tech product was "merely colorably different" from the Wolf product, which the consent decree had already adjudged to be an infringement. Interdynamics also argued that the Trans Tech product infringed the patent claims.

On both the contempt and infringement issues, the focus at the hearing was on whether the Trans Tech product had a "covering layer." Trans Tech argued that it omitted the covering layer when it changed its product from the two-sheet sandwich construction of the Wolf product to the single-sheet roll construction of the Trans Tech product. Interdynamics argued that the covering layer in the Trans Tech product was the backside of the rolled-up single sheet, the frontside of which was acting as the supporting layer.

On January 21, 1980, Judge Biunno issued a decision holding that the Trans Tech product did not infringe the Barnard patent [A.1]. The holding of noninfringement rested in part on Judge Biunno's finding that the prior art and the doctrine of filewrapper estoppel precluded Interdynamics from arguing that the Trans Tech product was an infringement [A.5 & 9n.2]. Judge Biunno also found that the Trans Tech product did not have the "spaced array" of heating elements called for by the patent claims [see A.6-7]. In making the latter finding, Judge Biunno ignored the fact that the configuration of heating elements in the Trans Tech product is identical to the config-

uration in the Wolf product, which the consent decree had already adjudged to be infringing. Thus, Judge Biunno failed to give res judicata effect to the consent decree. Instead, he examined the issue of patent infringement de novo.

In Judge Biunno's view, the finding of noninfringement of the patent claims disposed of the issue of civil contempt. He made no finding on whether the Wolf and Trans Tech products were merely colorably different [A.9n.1]. Interdynamics appealed.

2. Proceedings In The Court Of Appeals

On appeal, as in the trial court, Interdynamics argued that the proper test for determining civil contempt of a patent injunction is whether the modified product is merely colorably different from the enjoined product. The Third Circuit Court of Appeals agreed and, in response to a statement by counsel for Trans Tech that the Court of Appeals had before it all the evidence necessary to determine the issue of colorable difference, the Court of Appeals went ahead and decided that the Trans Tech product was merely colorably different from the Wolf product and was therefore a civil contempt of the consent decree [A.23-24 & n.4]. In a footnote, the Court of Appeals said that it was not necessary to re-examine the trial judge's finding of noninfringement, but suggested in passing that the trial judge's finding was erroneous [A.24n.5].

The Third Circuit's rationale was essentially as follows. Consent decrees, although negotiated by the parties, are judicial acts entitled to res judicata and collateral estoppel effect, just like judgments entered after trial on the merits [A.18]. A party violating a consent decree is subject to the powers by which a court protects its judgments, including the power of contempt under 18 U.S.C. § 401(3) [A.18-19]. In a patent case where the consent decree enjoins the marketing of an original

product and where the enjoined party subsequently begins to market a modified product, the rule of law that gives binding effect to the consent decree, protects the patentee, and gives the enjoined party a reasonable opportunity to market new devices, is that civil contempt will lie only if the modified product is "merely colorably different" from the original product [A.21]. Whether two devices are merely colorably different from each other is determined by the doctrine of equivalents [A.22-23], which was promulgated by this Court in *Graver Mfg. Co.* v. *Linde Co.*, 339 U.S. 605, 608 (1950):

> "[I]f two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape."

On the facts, the Third Circuit found that the Trans Tech product was equivalent to the Wolf product and was therefore a contempt, saying [A.23-24]:

> "From our examinaiton of the record, we conclude that the change in the structure of the coiled sheets between the Wolf and the Trans Tech products did not omit any function of the Wolf product. The same work (protecting the heating strips) was done in precisely the same way (by covering with a low adhesion surface) to accomplish the same result (installation of a defroster). The change between the two products seems, on this record, to produce no greater efficiencies, and to omit or alter no function. Without deciding what constitutes the outer boundary of what is 'merely colorable,' it is clear to us that the Trans Tech product is within that boundary."

The Third Circuit explained that the set of devices that are merely colorably different from the original device is a subset of all infringing devices, saying [A.23]:

> "Even if the new product may infringe the patent, as long as it is more than 'colorably different' the in-

> fringement should not amount to a contempt nor should it be tested in contempt proceedings."

Thus, the Third Circuit clearly implied that a merely colorably different device must also be an infringing device.

The Court of Appeals stopped short of explicitly finding that the Trans Tech product infringed the Barnard patent. In a concluding footnote, the Court of Appeals said that its finding of contempt made a finding on the issue of infringement unnecessary, but suggested that the District Court's finding of non-infringement was erroneous because of its treatment of the array of heating elements [A.24n.5]:

> "5. In view of our disposition of this matter, we do not decide whether the Trans Tech product infringes the Barnard patent. The district court decided that it did not because it found the Trans Tech product lacks the Barnard product's prearranged array of heating elements. We note that appellees do not place their principal reliance on that purported distinction, possibly because of their recognition that the spatial relationship between the heating elements in the Trans Tech product does not differ from that of the Wolf product, which they had previously admitted infringed the Barnard patent."

REASONS FOR DENYING THE WRIT

1. The Decision Of The Third Circuit Court Of Appeals Is In Perfect Harmony With The Decisions Of The Other Circuits And The Decisions Of This Court

Trans Tech's main argument is that a determination of whether a modified product is merely colorably different from an infringing product mandates that the court examine the patent claims, the patent filewrapper, and the prior art. Trans Tech says that the Third Circuit Court did not examine those things in this case, and that this case is therefore in conflict

with decisions in other circuits [Pet. 8]. Interdynamics disagrees for two reasons.

First, the Court of Appeals *did* look to the patent, the patent filewrapper, and the prior art in making its decision. All those things were part of the record on appeal, and the Court of Appeals said that it examined the record in making its decision [A.23-24]:

> "Applying that doctrine [of equivalents] in this case, it is necessary to compare the Trans Tech product with the Wolf product to determine the significance of the presence or absence of a separate backing sheet. Because this turns on the exhibits in the record and on uncontroverted evidence, without the need for credibility assessments or other special evaluation by the district court, we may decide the issue without remand. *See Hopp Press, Inc.* v. *Joseph Freeman & Co.*, 232 F. 2d at 637.[4]
>
> "4. Counsel for appellee stated at oral argument before us that there is enough in the record for this court to make the decision on the issue of 'colorable difference.'
>
> "From our examination of the record, we conclude that the change in structure of the coiled sheets between the Wolf and the Trans Tech products did not omit any function of the Wolf product. The same work (protecting the heating strips) was done in precisely the same way (by covering with a low adhesion surface) to accomplish the same result (installation of a defroster). The change between the two products seems, on this record, to produce no greater efficiencies, and to omit or alter no function. Without deciding what constitutes the outer boundary of what is 'merely colorable,' it is clear to us that the Trans Tech product is within that boundary."

Thus, the Court of Appeals *did* examine the documents in the record, and after examining them found that contempt was "clear."

Second, even assuming arguendo that the Court of Appeals did not examine the patent claims, the patent filewrapper, and the prior art, the Third Circuit's approach was in perfect harmony with the decisions in the other circuits that have addressed the issue.

The leading case in the Second Circuit is *Hopp Press, Inc.* v. *Joseph Freeman & Co.*, 323 F.2d 636 (2 Cir. 1963). In that case there was no discussion of the patent claims, the patent filewrapper, or the prior art. The court looked only to the products, saying (id. at 638):

> "The only perceptible difference between the two tags is the shape of the numerals, a difference we deem to be only colorable. The defendant's tags perform substantially the same function in substantially the same way to accomplish the same result as the plaintiff's tags. See Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 608, 70 S.Ct. 854, 856, 94 L.Ed. 1097 (1950). If the defendant's old tag infringed the plaintiff's patent, as it was adjudicated to have done, we are unable to see why the new tag, which is in every essential aspect equivalent, does not also infringe."

The leading case in the Sixth Circuit is *Schlegel Manufacturing Co.* v. *USM Corp.*, 525 F.2d 775 (6 Cir. 1975), cert. denied 425 U.S. 912 (1976), where the court reaffirmed earlier decisions holding that the issue in a contempt proceeding involves equivalence of devices and does not require an interpretation of the patent claims or the prior art (525 F.2d at 781-82):

> "This Court in a number of decisions has established clearly the applicable rule in proceedings for contempt for violation of an injunction against infringement of a patent.
>
> "In *Field Body Corp.* v. *Highland Body Mfg. Co.*, 13 F.2d 626, 627 (6th Cir. 1926), we held:
>
> " 'The relation of the Morrison patent to other

> structures and the validity of certain of its claims are argued by counsel for appellant as though the adjudication of validity and infringement were under review. We are not concerned with the prior art, nor with an original interpretation of the claims of the patent. It suffices here that in an action between the parties the patent was held infringed by appellant's original structure. The question, then, is whether the modified structure is the equivalent of the original in its relation to the patent suit.' . . .

"In *Wadsworth Elec. Mfg. Co.* v. *Westinghouse Elec. & Mfg. Co.*, 71 F.2d 850 (6th Cir. 1934), Judge Simons, who wrote the opinion for the Court, followed *Field Body* and stated:

> " 'The question in proceedings for contempt for violation of an injunction against infringement is not one which relates to or involves the original interpretation of the claims of the patent. *Field Body Corporation* v. *Highland Body Mfg. Co*, 13 F.2d 626 (C.C.A.6). It suffices that in an action between the parties the patent was held valid and infringed, and the question is only whether the modified structure is equivalent to the original in relation to the patent in suit. "The proceeding for its punishment (for contempt) 'is a new and distinct proceeding, and is quite independent of the equities of the case on which the decree is founded.' "*Bullock Electric & Mfg. Co.* v. *Westinghouse Electric & Mfg. Co.*, 129 F. 105, 106 (C.C.A.6). Were the rule otherwise, and were it permissible upon every proceeding in contempt to again challenge the validity of the claims, and to reopen issues already decided, such practice would be subversive, if not indeed wholly destructive, of the plenary power of the court to enforce its decrees, and to reopen questions of validity upon an appeal from a contempt order would be to invite all defeated liti-

> gants in patent infringement suits to defy injunctional orders, and by such defiance to seek review of adjudicated issues not otherwise open to them. We think it clear that the only issue presented by this appeal is whether the defendant's modified structures infringe the patent claims, and whether their manufacture violates the writ of injunction, and upon that issue neither the court below nor this court need consider the prior art. *Field Body Corporation* v. *Highland Body Manufacturing Company, supra.* (851-852)' "

The leading case in the Eighth Circuit is *Siebring* v. *Hansen*, 346 F.2d 474 (8 Cir. 1965), cert. denied 382 U.S. 943 (1965), where the court refused to examine the patent claims in a contempt preceeding (346 F.2d at 477):

> "In a contempt proceeding for alleged violation of an injunction entered pursuant to a consent decree in the original action, the validity of patent claims is not in issue. . . .
>
> "A contempt proceeding for violation of a patent infringement injunction will lie where the new and alleged offending device is merely 'colorably' different from the enjoined device or from the patent. . . .
>
> "Thus, in light of the settled state of the law which delineates the issues that may permissibly be adjudicated in a contempt proceeding, we find no merit in appellant's contention that the court erred in failing to adjudicate the validity of the Hansen patent. That question has been conclusively settled and determined by the consent decree and is res judicata for purposes of this appeal."

Cf., *United States ex rel. Shell Oil Co.* v. *Barco Corporation*, 430 F.2d 998, 1001-02 (8 Cir. 1970) (refusing to consider prior art).

The leading case in the Tenth Circuit is *McCullough Tool Company* v. *Well Surveys, Inc.*, 395 F.2d 230 (10 Cir. 1968), cert. denied 393 U.S. 925 (1968). There, the infringer argued

that the trial court had erred in excluding evidence concerning the issues of (a) the breadth of the patent claims, (b) the content and effect of the prior art on the patent claims, (c) the differences between the operation of the device described in the patent and the infringer's modified device, and (d) the non-equivalency of structure in the modified device and the structure in the device described in the patent (395 F.2d at 233). The Tenth Circuit affirmed the exclusion of evidence on these issues, saying (id. at 234):

> "The validity of the Swift Patent and the scope of its claims were conclusively determined as between the two parties in the instant suit in the original infringement suit. See Krentler-Arnold Hinge Last Co. v. Leman, 1 Cir., 50 F.2d 699. And Wadsworth Electric Mfg. Co. v. Westinghouse Electric & Mfg. Co., supra. This conclusively answers McCullough's claims that it should be allowed to introduce evidence upon issues (a) and (b).
>
> "There is also no merit to McCullough's argument as to issues (c) and (d). The difference between the modified structure and the original device found to infringe the Swift Patent is sufficiently established in the record by an affidavit filed by McCullough to decide the issue of contempt. . . . This change is merely a change in form with the new form serving the same function as the old, therefore, making the change a mere colorable variation justifying the trial court's finding of contempt."

In the present case, the Third Circuit Court of Appeals followed the same rule of law that has been followed by every other circuit court to address the issue. The consent decree established the validity and minimum scope of the Barnard patent claims and established the fact of infringement by the Wolf product. Those issues could not be re-examined, for to do so would undermine the doctrine of res judicata. The only open issue in the subsequent contempt proceeding was whether the

Trans Tech product was merely colorably different from the Wolf product.

Counsel for Trans Tech stated during oral argument that the Court of Appeals had enough information to decide that issue [A.23n.4], and the Court of Appeals decided it in Interdynamics's favor, saying that in light of the record the equivalence of the two devices was "clear" [A.24] In making its finding of equivalence, the Court of Appeals considered all the evidence, including the admission by the designer of the Trans Tech product that the protective function of the covering layer "had to be performed" and *was* performed in the Trans Tech product by the backside of the single sheet.* This Court has said, "A finding of equivalence is a question of fact." *Graver Mfg. Co.* v. *Linde Co.*, 339 U.S. 605, 609 (1950). Trans Tech's petition is nothing but a request for rehearing on a question of fact.

Nothing in the Third Circuit's decision suggests that it intended to depart from the precedents set in the other circuits. To the contrary, the Third Circuit's citation, and approval, of *McCullough Tool*, *Siebring*, and *Hopp Press* shows that the Third Circuit merely followed well-settled rules of law. In no way is there conflict between the Third Circuit and the other circuits.

Nor is there any conflict with the decisions of this Court. Trans Tech argues that *Graver Mfg. Co.* v. *Linde Co.*, 339 U.S. 605 (1950), and *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), require analysis of the prior art and the patent filewrapper before a court may reach a conclusion on the issue of contempt. Those cases concern ordinary infringement proceedings in which the issue is whether the alleged infringer's device falls within the scope of the patent claims. In that context, the prior art and the patent filewrapper are important

* Affidavit of Robert Hanser sworn to November 8, 1978 ¶ 18; transcript of hearing held on November 9, 1978 at 147 and 157.

because they shed light on the breadth of the claims. But in the context of the present case—the context of civil contempt—the scope of the patent claims has already been determined by the consent decree. The issue here is whether the Trans Tech product is merely colorably different from the Wolf product, which the consent decree has already established to be an infringement of the patent claims. The prior art and the patent filewrapper need not be considered in the decision of that issue.

2. The Decision Of The Third Circuit Court Of Appeals Necessarily Implies A Finding Of Infringement Of The Patent Claims

Trans Tech asserts that the Third Circuit's decision permits patentees to gain "undeserved extensions" of narrow patents and to "restrain legitimate non-infringing competition" [Pet.7]. That is not so. The Third Circuit's decision makes it clear that, if the Third Circuit were to decide the issue of infringement, it would find that the Trans Tech product infringes the Barnard patent claims.

The following language from the Third Circuit's opinion shows that the set of devices that are merely colorably different from the enjoined device is a subset of all infringing devices, so that a finding of mere colorable difference necessarily implies a finding of infringement [A.23]:

> "Even if the new product may infringe the patent, as long as it is more than 'colorably different' the infringement should not amount to a contempt nor should it be tested in contempt proceedings."

Other circuit courts have said that a finding of infringement necessarily follows from a finding of mere colorable difference. See *Siebring* v. *Hansen*, 346 F.2d 474, 480 (8 Cir. 1965), cert. denied 382 U.S. 943 (1965); *McCullough Tool*

Company v. *Well Surveys, Inc.*, 395 F.2d 230, 235 (10 Cir. 1968), cert. denied 393 U.S. 925 (1968).*

The Third Circuit properly ignored the District Court's finding of noninfringement, because the District Court committed the blatant legal error of ignoring the doctrine of res judicata. That legal error led the District Court to commit the further error of finding that the Trans Tech product lacked an "array" of heating elements, even though the configuration of heating elements in the Trans Tech product was identical to the configuration of heating elements in the admittedly-infringing Wolf product.

* Trans Tech took the same position before the Court of Appeals, arguing: "Appellee suggests that, in the usual situation, the infringing product and the range of colorable variation around it constitutes a scope substantially less than the scope of the patent claims" (Brief for Defendant-Appellee Trans Tech, Inc. at 43).

CONCLUSION

A writ should not be granted. "The jurisdiction to bring up cases by certiorari . . . was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing." *Magnum Co.* v. *Coty*, 262 U.S. 159, 163 (1923). Nothing more is being sought here.

Respectfully submitted,

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